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IN THE

Supreme Court of the United States

OCTOBER TERM, 1964

No. 253

MOHASCO INDUSTRIES, INC.,
Petitioner,

vs.

E. T. BARWICK MILLS, INC.,

AND

BARWICK CARPET MILLS, INC.,
Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

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ACKERMAN PRESS, Phones BO 9-7107-8

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Petitioner, Mohasco Industries, Inc., prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Fifth Circuit entered in the above case on January 22, 1965.

Opinions Below

The opinion of the Court of Appeals is reported at 340 F. 2d 319 and affirms a decision of the United States District Court for the Northern District of Georgia reported at 221 F. Supp. 191. Copies of both opinions are printed in Appendix B hereto.

Jurisdiction

The judgment of the Court of Appeals was entered on January 22, 1965, and an order denying a timely petition for rehearing was entered on March 18, 1965. Copies of the judgment and order are printed in Appendix B hereto.

The jurisdiction of this Court is invoked under 28 U. S. C. Sec. 1254 (1). The basis for jurisdiction in the District Court was 28 U. S. C. Sec. 1338(a).

Questions Presented

In this patent infringement action, the sole defenses were that the two patents in suit are invalid under 35 U. S. C. Sec. 103 and were not infringed. On August 30, 1963, the District Court filed an opinion (App. B pp. 4a-16a), which, except for minor editorial changes and omissions, was a verbatim copy of the first twenty-four pages and a part of page 25 of a pre-trial memorandum (I 136-160)[1] filed by respondents more than four months before the trial started. The Court also adopted, with inconsequential changes, findings of fact (App. B pp. 16a-31a) prepared by respondents and adopted, without change, conclusions of law (App. B p. 31a) prepared by respondents. The conclusions were that both patents are invalid because they define an "obvious use" of a known "principle" and that neither patent was infringed.

Of the three principal findings on which the conclusion of invalidity is based, Finding No. 12 (App. B p. 23a) ignores major differences between the patented devices and the prior art and sets forth only the difference between simplified models illustrative of a single feature of the patented devices and the prior art. The second and third

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[1] The references are to pages in volumes I to V, incl., of the printed record prepared for the Court of Appeals. Nine copies of the record have been filed with this petition.

of the principal findings, No. 10 (App. B p. 21a) and No. 15 (App. B p. 24a), are in direct conflict with the record. The single finding, No. 25 (App. B p. 30a), relating to infringement is contrary to the record.

In a *Per Curiam* opinion (App. B p. 34a) containing no discussion of the issues and no clue to the manner of arriving at its decision, the Court of Appeals said merely that it was "in agreement with the result reached by the trial court" and, in an order denying a petition for rehearing (App. B p. 36a), the Court said that it considered "the opinion of the District Court sufficiently informative, and a correct disposition of the issues presented".

The questions presented are:

1. Whether, in this case, the Court of Appeals "has so far departed from the accepted and usual course of judicial proceedings" or has "so far sanctioned such a departure" by the trial court "as to call for an exercise of this court's power of supervision" (Rule 19(1)(b)); and

2. Whether the District Court and the Court of Appeals properly applied Sec. 103 and the applicable rules of law in deciding the issues of validity and infringement.

Constitutional Provision, Statutes, and Rules Involved

This case involves Article I, Section 8, clause 8, of the Constitution, Sections 103 and 112 of Title 35 of the United States Code, Rule 52(a) of the Federal Rules of Civil Procedure, and Rule 19(1)(b) of this Court, all of which are printed in Appendix A hereto.

Statement of the Facts

Petitioner has been a manufacturer of woven carpets for many years and has made tufted carpets since early 1953 (I 234-6; 239). Respondents are a manufacturing and a

selling company of common ownership which began to make and sell tufted carpets in the fall of 1950 (II 765).

The patents in suit cover attachments for use with tufted carpet machines to make possible the production of carpets having a pile of high and low loops of yarn arranged in accordance with a predetermined pattern.

Tufted carpets are made on special sewing machines equipped with a row of vertical needles at a close spacing such that a machine for making carpet 15 feet wide[2] has over a thousand needles (III 1307). Near its pointed lower end, each needle has an eye threaded with a pile yarn and, in the operation of the machine, the needles are reciprocated vertically at a high speed[3] and, on each down stroke, the needles pass loops of pile yarn through a backing sheet, usually of burlap. The machine is provided with a row of hooks, one for each needle, mounted below the sheet and, near the bottom of the down stroke of the needles, the hooks swing to enter the loops of pile yarn carried by the needles. As the needles rise, the hooks retain the loops until the needles are clear of the sheet, whereupon the sheet moves forward, the hooks release the loops, and the needles descend again. The operations are repeated until the backing sheet has been fully tufted and has a pile made of loops of pile yarn in rows extending both across and lengthwise of the sheet. The pile yarns are fed to the needles by a feed roll and the height of the loops is determined by the rate of feed of the yarns (II 534).

Prior to the inventions of the patents in suit, Boyles applied for patent 2,876,441 (V 1915) on a method of making a tufted fabric with a pile formed of high and low loops arranged according to a pattern. The Boyles method involves feeding pile yarns to tufting needles in varying

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[2] The 15-foot tufting machine is the one most widely used.

[3] Tufting machine speeds of 600 stitches per minute are common (III 1308).

lengths and is described in the patent as practiced by an attachment having three feed rolls feeding separate groups of pile yarns and capable of being operated independently of one another under the control of a pattern mechanism at a high speed or a low speed. The speed of a roll determines whether the yarns fed thereby will form high or low loops and the pattern mechanism controls the speed of the individual rolls and produces an arrangement of the loops according to the pattern.[4]

Pattern attachments with multiple feed rolls for practicing the Boyles method first appeared on the market in 1952 and 6-roll attachments were in common use before the inventions of the patent in suit (II 838-9). The trade soon found that feeding the yarns in large groups[5] by a 6-roll attachment restricts the patterns made to simple geometric forms and prevents the production of patterns with floral effects (II 890-1) common in Wilton carpets for many years (II 941). The tufters wanted to produce "any kind of pattern we wanted to and any practical heights of pile" (II 811) and this required independent control of individual pile yarns being fed to the tufting machine needles (II 811).[6] The problem was to devise an attachment for a tufting machine which would effect such single yarn control. Obviously, a roll attachment would be impractical for the purpose since it would be necessary to provide a roll for each yarn and pattern mechanism for controlling the speed of the individual rolls.

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[4] The District Court referred to the "Boyles' controlled-feed principle" in Finding 14 (App. B p. 24a). Presumably the Court had in mind the Boyles method above described.

[5] Each roll of a 6-roll attachment for a 15 ft. tufting machine feeds more than 160 yarns and, transversely of the carpet, the loops of all yarns fed by the same roll are alike, either high or low.

[6] Such control is sometimes referred to as "single needle control" (II 577) and "single end control". In the carpet trade, an "end" is a pile yarn.

The slat attachments of the patents in suit, Odenweller, 2,853,032 (IV 1413) and Crawford 2,853,033 (IV 1418), both issued to petitioner on September 23, 1958, were the first practical tufting machine pattern attachments capable of providing single yarn control. Respondents do not deny that the patented attachments were the first solution of the problem.

The Odenweller '032 patent discloses an attachment which includes a roll or drum having a set of lengthwise teeth or slats and a smaller diameter roll or pinion having a set of slats meshing with those on the drum. The drum and pinion rotate on fixed centers and are driven at a uniform rate and the pile yarns pass between and are fed to the tufting machine needles by the meshing slats. The slats are long enough to feed a large number of yarns and the yarns are guided to lie side by side as they pass between the drum and pinion. The lengths of the yarns fed at any given rate of rotation of the drum and pinion depend on the height of the slats and the degree to which they are meshed. The pinion slats are of the same height from end to end but the slats on the drum have notches of varying depths in accordance with a predetermined pattern. The notching of the drum slats has the effect of varying the degree of mesh of the slats engaging respective individual yarns, so that, although the drum and pinion rotate at a uniform rate, each individual yarn may be fed at predetermined varying rates, depending on the depth of the particular notches in which it has been received, in order to produce the desired pattern of loops in the carpet.

The Odenweller '032 patent covers broadly a new combination of elements, of which the drum with the slats notched in accordance with a pattern is new. The combination produces a new result, namely, independent control of individual pile yarns being fed.

Odenweller conceived his invention in the late fall of 1953 and completed it by filing his patent application on April 1, 1954.

The Crawford '033 patent covers an improved form of the Odenweller attachment, in which each set of slats is mounted on endless chains and the chains pass between fixed parallel guides, so that a number of slats of each set held in unchanging mesh by the guides grip and feed the yarns with no chance of slippage. The slats of one set are notched in accordance with a pattern so that, although the slats and chains travel at a uniform rate, individual yarns are fed at varying rates as required by the pattern.

Crawford's conception of the invention occurred in late 1953 and he completed the invention by filing his patent application on July 22, 1954.

The patents are of great commercial importance and the slat attachment has become the "mass production" attachment of the industry (III 1195; 1225). The importance of the patents can be judged from the fact that, at the time of the trial, about 3½ years after the first license was granted, petitioner, its licensees, and respondents had in use nearly 90 slat attachments of the Crawford type, of which 17 attachments were in use by respondents. In the period mentioned, the licensees paid royalties of about $528,000 (IV 1831; V 1861). One of the licensees said that the slat attachment is "a significant milepost in the development of an industry that has exceeded all expectations" and is "the finest addition that has ever been made to it" (IV 1697).

For years prior to the patents in suit, circular knitting machines had been provided with furnishing wheels for supplying yarn to the knitting needles in accordance with the demand of the machine so that the machine would produce uniform stitches (III 1327-9). Such furnishing wheels are commonly a pair of meshing gears feeding a single yarn between them and one gear rotates on a fixed center and the other is movable relative to the first to adjust the degree of mesh of the teeth and thus vary the rate of yarn feed. In some furnishing wheel devices, the

movable gear is moved by hand to adjust the mesh of the teeth and the rate of yarn feed, while, in others, the movable gear is moved automatically by changes in tension in the yarn with an increase in tension producing an increase in mesh and a faster feed and vice versa. Hand operated and automatic furnishing wheels are disclosed, respectively, in the patents to Howie 1,581,093 (IV 1570) and Lawson 2,247,244 (IV 1593) cited in the applications for the patents in suit. Respondents cited the patents to Sawyer 2,432,685 (V 1995) and Lawson 2,247,245 (V 2003) which disclose automatic furnishing wheels. The furnishing wheel devices of the Sawyer and the two Lawson patents are closely similar (III 1334, 1338). Furnishing wheels do not grip the yarn tightly and no one has ever used a pattern device for controlling the action of furnishing wheels (III 1331). Since automatic furnishing wheels respond to changes in the tension of the yarn being fed and such changes are accidental and differ with different yarns, a pair of wheels can feed only one yarn (III 1348).[7] The testimony on these points is undisputed.

The trial court based its conclusion of invalidity in part on Finding No. 12 (App. B p. 23a), in which the court compared models (V 1985, 1987) illustrative of the Odenweller and Crawford forms of the slat attachment but for feeding a single yarn only, with a pair of furnishing wheels. The Court found that the only difference between the one-yarn models and the furnishing wheels was that, in the models, varying intermesh of the slats is obtained by varying the height of the slats, whereas, in furnishing wheels, varying intermesh of the teeth is obtained by varying the spacing between the wheel centers. The Court was either unaware of or forgot major differences between the slat attachment and furnishing wheels, as follows.

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[7] The District Court referred to the "intermeshing principle of furnishing wheels" in Finding 14 (App. B p. 24a). Presumably the Court had in mind that the rate of feed of a yarn by intermeshing teeth varies directly with the degree of mesh.

A slat attachment can feed an unlimited number of yarns independently of one another at varying rates and thus can feed the more than a thousand yarns used in a 15-foot tufting machine. The only way to feed a thousand and more yarns independently of one another by furnishing wheels would be to use more than a thousand pairs of wheels and a pattern mechanism not so far invented for controlling the action of the wheels. A slat attachment feeds the yarns as determined by the pattern mechanism built into the slats[8] to produce loops of non-uniform height required by the pattern, whereas furnishing wheels are used in order that a knitting machine may produce uniform stitches and the wheels respond to forces outside the attachment, namely, variations in yarn tension, to overcome the effect of such tension variations. The slat attachment feeds the yarns positively (I 393-4; II 931) whereas furnishing wheels feed the yarns with slippage (III 1331).

The Court's Conclusion 4 (App. B p. 31a) that the slat attachment involved only "an obvious use of the intermeshing principle of yarn-furnishing wheels" is thus based on a finding which ignores major differences between "the subject matter" and the prior art, as prescribed in Sec. 103.

The second principal finding, No. 10 (App. B p. 21a), on which the conclusion of invalidity was based, was that Parker and Short, employees of Callaway Mills Company, invented both forms of the slat attachment in "a little more than a week after their first exposure to the problem".[9] The finding is in direct conflict with the record. Short testified without contradiction that the first time Parker

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[8] The pattern mechanism built into the slats is the notches in one set of the slats which vary in depth in accordance with the pattern.

[9] The "problem" was the construction of a device which would provide independent control of the individual pile yarns fed to the needles of a tufting machine.

and Short were exposed to the problem was late in 1953; their solution was an attachment wholly unlike the slat attachment and so impractical that it was discarded. In June, 1955, about 18 months after their "first exposure to the problem", they again attempted to obtain independent control of individual yarns being supplied to tufting machine needles and, this time after several days of thought, Parker devised and Short constructed a slat attachment (App. C pp. 38a-39a).

The third finding, No. 15 (App. B p. 24a), relied on by the trial court as a basis for the conclusion of invalidity, is that four different persons invented slat attachments "as soon as the desire to make them manifested itself" and that this is a "well-nigh conclusive demonstration" that to make an attachment is obvious. The finding is in direct conflict with the record. The four persons referred to are Odenweller, Crawford, Parker and Short, considered to be one person, and Williams.[10] The undisputed testimony is that, on their first attempt to solve the problem of independently controlling individual pile yarns in a tufting operation, Odenweller and Crawford both failed and did not conceive a slat attachment until months later (App. C p. 37a). Parker and Short failed on their first attempt and did not succeed until their second attempt, a year and a half later (App. C p. 38a). Williams understood the problem in 1950 and worked on it for years, but he did not hit upon the slat attachment until 1957 or 1958 (App. C p. 39a).

The trial court's Conclusion No. 5 that infringement was not proved (App. B p. 32a) is based on Finding No. 25 (App. B p. 30a) that the claims sued on are restricted to an attachment operated in synchronism with the needles of the tufting machine, that is, with the drum or chains

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[10] The opinion copied from a trial brief refers to three persons, namely, Odenweller, Crawford, and Parker and Short (App. B p. 7a).

advancing at such a rate that a wave of yarn gripped between intermeshing slats is released for each down stroke of the needles. The finding is that both patents require synchronized operation, the patent specifications emphasize synchronization of machine and attachment as essential, and petitioner's witnesses testified at length as to the importance of synchronization.

There is not one word in either patent requiring that the patented attachment be operated in synchronism with the needles of the tufting machine with which it is used, and nothing in the history of either patent restricts the claims to synchronization. The patents describe synchronization of attachment and machine in compliance with the requirement of 35 U. S. C. 112 that the specification describe the "best mode contemplated by the inventor of carrying out his invention." Plaintiff's witness Lawrence said that synchronization is desirable but not necessary (I 358; II 529) and Crawford said the same thing (I 422-3). Respondents' witness Nix could point to no significant structural differences between respondents' slat attachments and those of the patents (II 642-3) and said that respondents might operate in synchronism or might not (II 620).

Reasons for Granting the Writ

1. The Court should grant this petition in the exercise of its supervisory authority because, in this case, the trial court has shirked its judicial duties and its derelictions have been sanctioned by the Court of Appeals. As a result, petitioner has been denied its rights and has suffered a gross injustice. The importance of the case transcends the issues involved and the rights of the litigants in that it affords the Court an unusual opportunity to correct practices of trial courts which ought to be terminated forthwith. The first of these practices has to do with opinions and the second with the fact finding process.

The trial court filed an opinion which, except for immaterial changes and omissions, was copied verbatim from respondents' pre-trial memorandum written by their counsel months before the trial began. The opinion contains many generalities and irrelevancies and is permeated with a philosophy antagonistic to the patent system and to patentees. Since the opinion was composed by an advocate before trial instead of by the trial judge after trial, it contains, as might be expected, merely a statement of what the advocate hoped to prove.

The use by the trial court for its opinion of a section of respondents' pre-trial memorandum constitutes a failure of the court to perform a judicial function of great importance to petitioner and is equivalent to having an opinion prepared by respondents' counsel without notice to petitioner. If an opinion is filed by a trial court, it ought to express the results of the judge's own independent labors, and it should be prepared only after a careful review of the evidence. The losing party is entitled to such a study of the record before a decision against him is handed down and, since an opinion is likely to be published and to be referred to in the future by both litigants and courts, a judge has a duty not to file opinions, which will not stand the closest scrutiny. In this case, the indifference of the court to the rights of petitioner is particularly flagrant because the opinion was not even based on evidence brought out at the trial. It has been held that there is no authority in the Federal Courts countenancing the preparation of an opinion by counsel for the winning party and that such action amounts to a denial of due process.[11] Fortunately, the practice of filing opinions written by counsel for the winning party does not seem to have spread widely among the lower Federal Courts but an overworked trial judge is likely to find it attractive. It is a practice so prejudicial

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[11] *Chicopee Mfg. Corp.* v. *Kendall Co.*, 288 F. 2d 719, 724 (4 Cir. 1961), cert. den., 368 U. S. 825 (1961).

to the rights of appellants that it ought to be stopped by this Court before it can spread further.

The second practice, which occurred in this case and which this Court should correct, is the mechanical adoption by the trial court of findings of fact prepared by counsel for the winning party. Although this practice has been condemned by most of the Courts of Appeals, and commentators[12] have inveighed against it, trial courts continue to follow it.

The requirement of Rule 52(a), F. R. C. P., is that, in "all actions tried upon the facts without a jury . . ., the court shall find the facts specially" and this rule is one of the most important safeguards of the rights of litigants in our judicial system. The requirement is intended to assist the appellate courts in the performance of their duties but its more important purpose is to attempt to insure that the trial court will exercise due care in ascertaining the facts and will make correct findings. Every judge preparing findings and every lawyer writing a brief know that what seems to be a clear recollection of testimony is frequently found incorrect when the recollection is to be put into words and the record is examined in that connection. The importance of correct fact finding to the defeated party in the trial court can hardly be exaggerated because the Rule provides that findings "shall not be set aside unless clearly erroneous", whereas an appellant is under no corresponding burden in seeking the correction of an error in the application of a rule of law. The acceptance of findings prepared by winning counsel inevitably leads to grave abuses in that counsel will naturally put his case as strongly as possible in such findings so that they are likely, as in the present case, to contain arguments, slanted statements, and half-truths, and to suffer from omissions. The trial court is then tempted to rely on his

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[12] Otis "Improvement in Statement of Findings of Fact and Conclusions of Law", 1 F. R. D. 83, 85; *U. S.* v. *El Paso Natural Gas Co.*, 376 U. S. 651, 656n (1964).

memory and may adopt such findings mechanically, as was done here, and without checking the record for support for them.

Appellate courts have said that findings prepared by counsel are "unfortunate and undesirable"[13] and less helpful than those resulting from "the independent judicial labors and study of the district judge".[14] Such findings have also been characterized as not "entitled to the same weight and dignity which they would have possessed had they represented the unfettered and independent judgment of the trial judge."[15] Despite the strictures placed by reviewing courts upon findings prepared by counsel, those courts grudgingly accept such findings, if supported by evidence. What the courts overlook is that the preparation of findings by winning counsel deprives the losing party of an important right, namely, the assurance that the findings represent the views of the trial court based on a review of the evidence. Moreover, the practice increases the chance of error by the trial court with a resultant increase in appellant's burden of showing that the findings are clearly erroneous.

In this case, petitioner has never had the benefit of the independent thought and judgment of the trial court. There is not a single statement of significance in the opinion or in the findings of fact and conclusions of law expressive of thoughts of the trial court, and the adoption by the court of findings which could so easily have been found to be in conflict with the record, as pointed out above, is strong proof that the court did not examine the record, despite any statements to the contrary.

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[13] *City of New York* v. *McLain Lines*, 147 F. 2d 393 (2 Cir. 1945).

[14] *Kinnear-Weed Corp.* v. *Humble Oil and Refining Co.*, 259 F. 2d 398, 401 (5 Cir. 1958), cert. den., 361 U. S. 903 (1959).

[15] *The Severance*, 152 F. 2d 916, 918 (4 Cir. 1945), cert. den., 328 U. S. 853 (1946).

The Court of Appeals merely expressed agreement "with the result reached by the trial court" (App. B p. 34a) and said (App. B p. 36a) that it considered "the opinion of the District Court . . . a correct disposition of the issues presented". Before coming to that view, the Court of Appeals may have examined the entire record but, if it did, it carefully refrained from saying so and from commenting on the evidence.

We believe that this petition should be granted not merely to give petitioner the day in court so far denied it but to afford this Court an opportunity to speak out with respect to the proper performance by trial courts of their judicial functions of writing their own opinions and preparing their own findings of fact and conclusions of law. A more shocking example than the present case of the injustice that can be done to a litigant by the failure of a trial court to carry out its duties and obligations could scarcely be found.

2. The decision of the Court of Appeals is believed to be erroneous in that the holding of invalidity is based on a misunderstanding of provisions of Sec. 103 which have not been and ought to be interpreted by this Court for the benefit of the lower courts.

Certiorari has recently been granted by this Court in five patent cases,[16] in each of which it will be necessary to consider provisions of Sec. 103. It is not likely that, in deciding these cases, there will be any occasion for a discussion of the meanings of the term "obvious" and of the phrase "the subject matter as a whole" appearing in the section. These parts of the section are vital and, if they are to be interpreted as has been done by the Court of Appeals in this case, the section will make it almost im-

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[16] *Graham* v. *John Deere Company*, No. 580, this term; *Calmar, Inc.* v. *Cook Chemical Co.*, No. 778, this term; *Colgate-Palmolive Co.* v. *Cook Chemical Co.*, No. 810, this term; *U. S.* v. *Adams*, No. 906, this term; *Hazeltine Research, Inc.* v. *Ladd*, No. 919, this term.

possible to patent any invention, regardless of its merit. This case, therefore, offers an opportunity for a pronouncement by this Court which will serve to guide the courts below in matters of great importance in patent law.

The Court of Appeals approved the finding (App. B p. 24a) of the District Court that "the fact" that four different persons were able to devise the slat pattern attachments of the patents in suit "as soon as the desire to make them manifested itself" was an almost "conclusive demonstration" that the attachments were obvious to a person having ordinary skill in the art. The record shows (App. C pp. 37a-38a) that, on their first attempt to achieve the control of individual yarns afforded by the patented attachment, three of the four persons did not at once devise a slat attachment but something entirely different which proved to be a failure. They invented the slat attachment on their second attempt, which occurred from 6 to 18 months after the first. About 6 years elapsed between the time the fourth person recognized the desirability of individual yarn control provided by a slat attachment and the time he constructed a model of a slat attachment and, in that period, he tried many things to obtain the desired effect but without success (App. C p. 39a). When the Court of Appeals says, in the face of the history of the efforts of the four persons mentioned, that the slat attachment is obvious, it is clear that the Court does not give the word "obvious" its ordinary dictionary meaning of "capable of easy perception; requiring very little insight or reflection to perceive, recognize, or comprehend",[17] instead, the court is using some meaning known only to itself. If the slat attachment, which took four persons respective periods of from six months to six years to devise, is obvious and unpatentable, then there is scarcely anything in the useful arts which is not equally obvious and unpatentable. It seems clear that the term refers to some-

[17] Webster's Third New International Dictionary (p. 1559).

thing which a person of ordinary skill, when faced with a problem, would adopt with little cogitation or delay on his first attempt to solve the problem. The undisputed testimony in the record as to the activities of the four persons shows that the slat attachment was anything but obvious.

Sec. 103 says that the differences between the patented subject matter and the prior art are to be the basis for determining whether "*the subject matter as a whole* would have been obvious at the time the invention was made to a person having ordinary skill in the art . . ." (emphasis ours). Since the obviousness of the subject matter "as a whole" is the criterion of patentability, it necessarily follows that the differences between the subject matter "as a whole" and the prior art are to be determined and employed as the test of obviousness. If all such differences are not considered, the phrase is without meaning and it is impossible to reach any conclusion as to the patentability of the subject matter as a whole.

In this case, the District Court paid lip service to Sec. 103 by saying that to "evaluate invention, one must first determine just what difference or differences exist between the patentee's contribution and the prior art" (App. B p. 10a). However, when faced with the task of determining the differences between the slat attachment of the patents and furnishing wheels, the Court considered only a single structural difference and ignored other structural differences and differences in purpose, mode of operation, and results obtained. The conclusion of the court that the patents define only "an obvious use of the intermeshing principle of yarn-furnishing wheels" (App. B p. 32a) is thus unjustified in view of the Court's failure to take into account all the factors to be weighed in determining obviousness.

In accepting without comment the findings and conclusions of the District Court on the question of obviousness,

the Court of Appeals has given tacit approval to misinterpretation of Sec. 103 on two critical points, namely, the meaning and significance of the term "obvious" and of the phrase "the subject matter as a whole". As the term and the phrase are the basis of the test of patentability defined in Sec. 103, this Court should give the lower courts the benefits of its views on the points by granting certiorari in this case and correctly applying the section.

3. The decision of non-infringement in this case is erroneous and involves a complete disregard of rules of law enunciated long ago and followed ever since.

The undisputed testimony is that the slat attachment of the patents in suit may be operated in synchronism with the tufting machine, with which it is employed, or out of synchronism with the machine (*supra* p. 11). The patents describe synchronized operation in compliance with the requirement of 35 U. S. C. Sec. 112 but nothing in the patents requires synchronized operation and nothing in the proceedings leading to the grant of the patents limits their scope to synchronized operation. There can be no doubt that respondents' slat attachments are in all essential respects of the same construction as those of the patents and function in the same way to produce the same result (II 620, 643).

The Court of Appeals erred in approving the trial court's conclusion of non-infringement, in that it has been held for years that the claims of a patent rather than the specification measure the scope of the protection and that a patent is, therefore, not to be limited to what is described and illustrated in it.[18] It is likewise a fundamental rule that every patent is entitled to the benefit of the doctrine of equivalents.[19] The Court of Appeals disregarded both

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[18] The Paper Bag Patent Case, 210 U. S. 405, 418 (1908).

[19] *Miller* v. *Eagle Mfg. Co.*, 151 U. S. 186, 207 (1894); *Graver Mfg. Co.* v. *Linde Co.*, 339 U. S. 605, 607 (1950).

rules and held that infringement of a patent by a device of essentially the same construction and mode of operation as that of the patent and producing the same result is avoided by running the device at a speed different from that recommended for the patented device when speed is not critical in either case. The mere statement of the basis of the conclusion shows how obviously erroneous it is.

Finally, in considering infringement of the Odenweller patent, the District Court violated the basic rule of claim construction that a limitation must not be implied in one claim if that same limitation appears in another.[20] The claims of the Odenweller patent, of which infringement is charged, contain no language restricting them to synchronized operation, but claim 5 is so limited. It is, therefore, improper to limit the claims sued on to synchronized operation in view of the presence of that limitation in claim 5. In accepting the conclusion of the District Court, that the claims were not infringed because of their being limited to synchronized operation, the Court of Appeals has sanctioned the violation by the District Court of this long established rule.

Conclusion

We recognize that this Court is reluctant to set aside concurrent findings of fact by two courts below but the "two court" rule contains an exception and will be disregarded when manifest error is shown.[21] This case should not be subject to the rule because it comes within the exception and because of the manner in which the findings were made.

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[20] *Symington Co.* v. *National Castings Co.*, 250 U. S. 383, 385 (1919).

[21] *Graver Mfg. Co.* v. *Linde Co.*, 336 U. S. 271, 275 (1949); *Goodyear Co.* v. *Ray-O-Vac Co.*, 321 U. S. 275, 278 (1944).

Undisputed testimony establishes that, of the four principal findings, on which the conclusions of invalidity and non-infringement were based, Findings Nos. 10, 15, and 25 are clearly erroneous. Finding No. 12 does not justify a conclusion that the patented "subject matter as a whole" was obvious because the finding considers a single difference between the subject matter and the prior art and disregards other and more important differences. The showing of error is "obvious and exceptional" as referred to in *Graver* and the "strong case" of *Goodyear* has been made out.

Although the District Court appears to have made findings of fact and the Court of Appeals concurred in them, the flat contradiction of the principal findings by the record makes it impossible to believe that the District Court did anything but mechanically adopt the findings prepared by respondents' counsel without reviewing the record and that the Court of Appeals likewise accepted the findings without a careful study of the record. In such a situation, concurrence in the findings is without significance and in no way adds to their weight or authority.

Certiorari should be granted, in order that this Court may put an end to the improper practices which occurred in this case, express its views as to the meaning of "obvious" and the "subject matter as a whole" as employed in Sec. 103, and give petitioner its day in court.

Respectfully submitted,

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JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1964

No. 253

MOHASCO INDUSTRIES, INC.,

Petitioner,

vs.

E. T. BARWICK MILLS, INC.,

AND

BARWICK CARPET MILLS, INC.,

Respondents.

APPENDICES TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

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APPENDIX A

Constitutional Provision

ARTICLE I—LEGISLATIVE DEPARTMENT

SECTION 8. LEGISLATIVE POWERS OF CONGRESS

"The Congress shall have power: . . .

"8. To promote the progress of science and useful arts, by securing for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries: . . ."

Title 35, United States Code

"§ 103. CONDITIONS FOR PATENTABILITY; NON-OBVIOUS SUBJECT MATTER

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

"§ 112. SPECIFICATION

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention. . . ."

Appendix A.

Federal Rules of Civil Procedure

RULE 52. FINDINGS BY THE COURT

"(a) Effect. In all actions tried upon the facts without a jury or with an advisory jury, the court shall find the facts specially and state separately its conclusions of law thereon, and judgment shall be entered pursuant to Rule 58; and in granting or refusing interlocutory injunctions the court shall similarly set forth the findings of fact and conclusions of law which constitute the grounds of its action. Requests for findings are not necessary for purposes of review. Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses. The findings of a master, to the extent that the court adopts them, shall be considered as the findings of the court. If an opinion or memorandum of decision is filed, it will be sufficient if the findings of fact and conclusions of law appear therein. Findings of fact and conclusions of law are unnecessary on decisions of motions under Rules 12 or 56 or any other motion except as provided in Rule 41(b). As amended Dec. 27, 1946, eff. March 19, 1948; Jan. 21, 1963, eff. July 1, 1963."

Appendix A.

Revised Rules of the Supreme Court of the United States

PART V. JURISDICTION ON WRIT OF CERTIORARI.

19.

CONSIDERATIONS GOVERNING REVIEW ON CERTIORARI.

"1. A review on writ of certiorari is not a matter of right, but of sound judicial discretion, and will be granted only where there are special and important reasons therefor. The following, while neither controlling nor fully measuring the court's discretion, indicate the character of reasons which will be considered:

* * *

"(b) Where a court of appeals has rendered a decision in conflict with the decision of another court of appeals on the same matter; or has decided an important state or territorial question in a way in conflict with applicable state or territorial law; or has decided an important question of federal law which has not been, but should be, settled by this court; or has decided a federal question in a way in conflict with applicable decisions of this court; or has so far departed from the accepted and usual course of judicial proceedings, or so far sanctioned such a departure by a lower court, as to call for an exercise of this court's power of supervision."

APPENDIX B

Opinion of District Court

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF GEORGIA

ATLANTA DIVISION

Filed and Entered in Clerk's Office
Aug 30 1963

B. G. NASH, Clerk
By: RJT, Deputy Clerk

CIVIL ACTION No. 7000

MOHASCO INDUSTRIES, INC.,
a New York corporation,

Plaintiff,

vs.

E. T. BARWICK MILLS, INC.,
a Georgia corporation,

and

BARWICK CARPET MILLS, INC.,
a Georgia corporation,

Defendants.

STATEMENT OF THE CASE

This cause came on to be tried before the Court, sitting without a jury, on February 4th through February 12th, 1963. This is an action for alleged infringement of two patents brought by Mohasco Industries, Inc., a New York

corporation (hereinafter referred to as Mohasco) against E. T. Barwick Mills, Inc., and Barwick Carpet Mills, Inc., both Georgia corporations. For the purposes of this suit, defendant Georgia corporations will be hereinafter referred to as Barwick. The patents alleged to be infringed are:

Patent	*Filed*	*Issued*	*Claims in Suit*
Odenweller No. 2,853,032	4/ 1/54	9/23/58	1, 3, 6, 8, 9
Crawford No. 2,853,033	7/22/54	9/23/58	1, 3, 4, 5, 8, 10, 11

A third patent, Crawford No. 2,853,034, which was originally charged to be infringed, has been withdrawn from suit.

The patents in suit relate to apparatus called "pattern attachments" which are applied to the large special-purpose sewing machines used for making tufted carpet. These attachments control the feed of yarn to the machines in such a way as to cause the machines to produce carpets in which some of the loops or tufts of the carpet are longer or higher than others, the low loops and the high loops being distributed over the surface of the carpet in a prearranged pattern.

Discussion

The principal defense which defendant Barwick asserts and claims to be controlling is that the patents are invalid in view of the statutory disqualification from patenting, citing the portion of 35 U. S. C., Section 103, which provides in part:

> "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole *would have been obvious* at the time the invention was made to a person having

ordinary skill in the art to which the said subject matter pertains." (Emphasis supplied.)

This statutory requirement that a patent may not be sustained if its subject matter "would have been obvious" to one skilled in the art is the principal ground of invalidity in a large proportion of the many cases in which patents, duly issued by the Patent Office, are held by the courts to be invalid.

It has long been a matter of concern that, despite concerted efforts to avoid the issuance of patents which do not meet the statutory requirements as interpreted and enforced by the courts, such patents, nevertheless, continue to be issued. That it is the duty of the courts to protect the public against the enforcement of patents which do not meet the statutory requirements is clear.

Before setting forth the Court's findings of fact and conclusions of law (proposed findings of fact and conclusions of law having been submitted by both the plaintiff and defendant in the case at hand) the Court shall review briefly what it construes to be the controlling principles of law in the matter.

It will be noted that the statutory requirement of unobviousness is in the subjunctive. The significance of this is to disqualify, as the subject of a valid patent, not merely what was in fact obvious to persons skilled in the art, but also what would have been obvious to a hypothetical person skilled in the art in the sense that he was aware of all the ramifications of the machinery and mechanical principles which have been used or suggested for use in the art, regardless of his actual knowledge of them, combined with the occasion and incentive to apply this knowledge. It is admittedly difficult to judge what "would have been obvious" to such a hypothetical person. In the present case, however, this difficulty largely disappears, for in this case the subject matter of the patents was in fact independently and spon-

taneously thought of almost simultaneously by a number of persons concerned with the problem, in different parts of the country,[1] as soon as the occasion to do so arose.[2] The fact that all three concerned themselves with the problem at about the same time and independently built the patent attachments demonstrates to this Court that the subject matter "would have been obvious".

Since patents are restrictions upon the natural right of members of the public to avail themselves of the abilities of skilled artisans, and upon the right to free competition which is basic to our economic system, monopolies based on patents must be jealously scrutinized by the courts to make certain that they are of the character which the statutes authorize. As the Supreme Court said in *A. & P. Tea Company* v. *Supermarket Corporation*, 340 U. S. 147, 152, 154-55 (1950):

> "The function of a patent is to add to the sum of useful knowledge. Patents cannot be sustained when, on the contrary, their effect is to subtract from former resources freely available to skilled artisans" (p. 152).
>
> • • •
>
> "Every patent is the grant of a privilege of exacting tolls from the public. The Framers plainly did not want those monopolies freely granted. The invention, to justify a patent, had to serve the ends of science—to push back the frontiers of chemistry, physics, and the like; to make a distinctive contribution to scientific

---

[1] (a) Odenweller of James Lees & Sons of Philadelphia, Pennsylvania, 1954;

(b) Crawford of Mohawk (later Mohasco) of Amsterdam, New York, 1954;

(c) Parker and Short of Callaway Mills Company of LaGrange, Georgia, 1955.

[2] Parker and Short built a model slat attachment in a period of a little more than a week after having been exposed to the problem.

knowledge. That is why through the years the opinions of the Court commonly have taken 'inventive genius' as the test. It is not enough that an article is new and useful. The Constitution never sanctioned the patenting of gadgets. Patents serve a higher end—the advancement of science. An invention need not be as startling as an atomic bomb to be patentable. But it has to be of such quality and distinction that masters of the scientific field in which it falls will recognize it as an advance. Mr. Justice Bradley stated in *Atlantic Works* v. *Brady*, 107 U. S. 192, 200, the consequences of a looser standard:

> " 'It was never the object of those laws to grant a monopoly for every trifling device, every shadow of a shade of an idea, which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufactures. Such an indiscriminate creation of exclusive privileges tends rather to obstruct than to stimulate invention. It creates a class of speculative schemers who make it their business to watch the advancing wave of improvements, and gather its foam in the form of patented monopolies, which enable them to lay a heavy tax upon the industry of the country, without contributing anything to the real advancement of the arts. It embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to lawsuits and vexatious accountings for profits made in good faith.' "

To the same effect are the holdings of the Court of Appeals of this Circuit in *Glikin* v. *Smith*, 269 F. 2d 641, 651 (5 Cir. 1959), cert. denied 361 U. S. 915:

> "The patentee's claims, as he construes them in this case, are broad in scope and far-reaching in effect.

Appendix B.

> A substantial segment of the hearing aid industry and an enormous number of the hard of hearing public will be affected if the patentee's contentions should be sustained in this litigation. In the circumstances, the interest of the public, paramount to the interests of the patentee and of the user of the accused device, compels a close scrutiny of the plaintiff's claim of invention."

and in *Stabler* v. *Bright Leaf Industries, Inc.*, 261 F. 2d 383, 385 (5 Cir. 1958), cert. denied 359 U. S. 960 (1959):

> "Inventions require close scrutiny lest patent monopolies be granted to 'each slight technological advance in an art' merely because it is useful."
>
> See also *Anthony* v. *Ranco, Incorporated,* 316 F. 2d 509, 512 (5 Cir. 1963).

The patent statutes set forth certain requirements which must be met if a patent is to be held valid. The most important of these, the requirement of "invention", is the focal issue in this case.

Here the question of patentability boils down to the question of invention, that is, whether the subject matter "would have been obvious" to one skilled in the art so as to come within the prohibition of Section 103 of the patent statutes quoted above. Barwick contends that the devices disclosed and claimed in the patents in suit do not involve invention.

Generally, all patents, publications and public uses which have been in existence prior to a patentee's date of invention or more than a year prior to his filing date are referred to as "prior art". If a patentee's alleged invention is identically disclosed in the prior art, it clearly is not new. In such a situation, the alleged invention is said to lack novelty and the patent must be declared to be invalid.

Appendix B.

It is where the patentee's alleged invention is not identically disclosed in the prior art as defined above, and, therefore, is not directly anticipated, that the conception of "invention" or "obviousness" becomes an issue. To evaluate invention, one must first determine just what difference or differences exist between the patentee's contribution and the prior art, and then determine whether this difference measures up to the statutory definition of invention.

In making inquiry regarding obviousness, it is important to note that the prior art includes all patents, publications and uses, etc., irrespective of whether a particular patentee was aware of them or not. Certainly no one person could possibly keep abreast of all the scientific and engineering advances in this rapidly changing world, but the purpose of the patent law is to encourage the disclosure of new, non-obvious developments, and the monopoly which a patent carves out of the public domain is granted only in exchange for such developments. Therefore, a patentee's contribution must be measured against the entire body of prior art, and he is presumed by law to have been familiar with the whole prior art as it existed at the time he made his contribution. See *Mast, Foos & Company* v. *Stover Manufacturing Company,* 177 U. S. 485, 494.

The hypothetical person "having ordinary skill in the art" has been characterized by the cases as a person of education and training in his art. Speaking with regard to the communications art, the Court in *Radtke Patents Corporation* v. *Coe,* 122 F. 2d 937, 946 (D. C. Cir. 1941), cert. denied 314 U. S. 695 (1941) defined persons skilled, and their knowledge of their calling, thus:

> "the knowledge of the prior art is not limited to the knowledge of lawyers or of the public generally, but is that of the experts and scientists, the trained engineers who have been working for many years in the electrical art of sound communication. If expert testi-

mony and prior scientific publications reveal such knowledge, sufficient to teach such men or to suggest to them what is here claimed to be invention, then the fact that such claims may seem remarkable, or new, or profound, to lawyers or to the public generally, is not sufficient to constitute invention."

Likewise, cases hold that obviousness must be measured in terms of persons whose business it is to design and build the things in question, not those who only use them. For example, what in the present case would have been obvious to a tufting machine designer cannot be inventive no matter how obscure or mysterious it might have seemed to a carpet manufacturer who merely uses such machines and consequently has no occasion to be concerned with the intricacies of their design. *Zoomar, Inc.* v. *Paillard Products,* 152 F. Supp. 328, 331 (S. D. N. Y. 1957), affirmed 258 F. 2d 527 (2 Cir. 1958), cert. denied 358 U. S. 908 (1958).

The test of obviousness as the test of invention is not new with the quoted section of the Patent Act of 1952, although it was first expressed by statute at that time. Long before the statute was enacted, the courts had applied the test, first announced by the Supreme Court in 1850 in *Hotchkiss, et al.* v. *Greenwood, et al.,* 11 How. (52 U. S.) 248, 266 (1850). To the same effect are the consistent holdings of the Court in a long line of cases such as *A. & P. Tea Company* v. *Supermarket Corporation, supra,* and *Atlantic Works* v. *Brady,* 107 U. S. 192, 200.

Nor was Section 103 intended to change or modify in any way the standard of invention as expressed by the prior decisions, *Vincent* v. *Suni-Citrus Products Company,* 215 F. 2d 305, 315-16 (5 Cir. 1954), cert. denied 348 U. S. 952 (1955):

"The object and purpose of the patent statutes is to promote really novel advances in the art, rather than those attributable merely to a person having ordinary

skill in the trade. The judgment in this case was entered before the enactment of Section 103 of the Patent Act of 1952, 35 U. S. C., Sec. 103, and this section, therefore, is not specifically applicable in the decision of this case. Nevertheless, since the section purports and has been construed to merely embody existing law, . . ."

* * *

"It is sufficient to say that, if we should assume that either of these processes is new in the sense of not having been tried before, we should be obliged to hold that they present nothing novel since what they purport to do would have been perfectly obvious, at the time the invention was made, to a person having ordinary skill in the art of liming and drying citrus waste. Though, therefore, that process may be as useful and efficient as other liming and drying methods are, or even more so, nevertheless, it is perfectly plain that they claim nothing which so advances the art as to justify monopoly protection. Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp., 294 U. S. 477, at page 486."

Subsequent opinions in the Fifth Circuit have reaffirmed this view. See *Glikin* v. *Smith,* supra, and *Stabler* v. *Bright Leaf Industries, Inc.,* supra.

Finally, it should be noted that while obviousness is the test of invention, this test is to be applied more strictly in the case of combination patents. A "combination patent" claims an invention which purports to be a new combination made up of a number of elements, each of which itself is old. The courts have held that there is an inherent improbability that the subject matter of such patents can amount to invention, and therefore combination patents are viewed critically. *A. & P. Tea Company* v. *Supermarket Corporation,* supra.

Appendix B.

In striking down a combination patent in *Fritz W. Glitsch & Sons* v. *Wyatt Metal & Boiler Works,* 224 F. 2d 331, 334 (5 Cir. 1955), the Court of Appeals of this Circuit referred to "the stricter test for patentable invention now required to justify monopoly protection". In *Glikin* v. *Smith,* 269 F. 2d 641, 651-52, the Court of Appeals of this Circuit held:

> "A presumption of validity attaches to a patent. Because of this presumption and because a patent is a legislatively condoned monopoly that is not granted willy nilly to just any advance or improvement in commerce, combination patents are viewed strictly. This is particularly true where the elements in the combination are old and known to the art, since a liberal construction of such combination claims would erase the line, such as it is, between mechanical judgment and inventive skill."

The patents sued on in this case are for combinations.

To be sure, the issuance of a patent carries with it a presumption of validity (35 U. S. C., Sec. 282) but the Courts recognize the problems which inhere in an immense administrative operation such as is carried on by the Patent Office and have minimized the presumption accordingly. See *Gentzel* v. *Manning, Maxwell & Moore, Inc.,* 230 F. 2d 341, cert. denied 352 U. S. 840; *Wabash Corporation* v. *Ross Electric Corporation,* 187 F. 2d 577.

The fact that the Patent Office issues a patent does not necessarily mean that the subject matter was patentable. Pursuant to a rule of long-standing, still in existence today, the Patent Office must grant a patent even when in doubt as to its patentability. *In re Thomson,* 26 App. D. C. 419, 1906 C. D. 566, 571 (1906):

> "In case of ordinary doubt, the policy of the patent system, as customarily maintained in the Patent Office,

has been to give the applicant the benefit thereof, because no absolute right of property is conferred by the grant of a patent. (*Ex parte Fanshawe*, C. D., 1891, 203; 57 O. G., 1127). The patentee is merely put in a position to assert his *prima facie* right against infringers who may, in their defense, raise the question of the validity of the patent, and have the same finally adjudicated in the light of a full presentation and consideration of all the evidence attainable in respect of anticipation, prior knowledge, use and the like."

See also *Application of Hummer*, 241 F. 2d 742, 746, and *Application of Citron*, 251 F. 2d 619, 620.

Considering what has been said, it is hardly surprising that Courts have observed that the standard of patentability in the Patent Office is below that required by the Courts. *Packwood* v. *Briggs & Stratton Corporation*, 195 F. 2d 971, 974 (3 Cir., 1952) cert. denied 344 U. S. 844 (1952); *Picard* v. *United Aircraft Corporation*, 128 F. 2d 632, 641 (2 Cir. 1942) cert. denied 317 U. S. 651 (1942):

"The Patent Office grants from 50,000 to 100,000 patents each year. The Committee of the Science Advisory Board reported that it was one of the primary defects in our patent system that the Patent Office issues 'an enormous number of patents, many of which should never be issued * * *' That probably means, as the Committee intimated, that *the standard of inventiveness employed by the Patent Office is far below that employed by the courts.*" (Emphasis supplied.)

The history of the development of the attachment here concerned constitutes, in this Court's opinion, the most reliable evidence as to the presence or absence of invention. When several persons, such as Odenweller of James Lees, Crawford of Mohasco, and Parker and Short of Callaway,

addressing themselves to the same alleged problem each independently arrive at the same solution shortly after the problem is presented, lack of a patentable invention is strongly indicated.

In evaluating "invention", that is, obviousness, the critical importance of the surrounding circumstances was emphasized by Judge Learned Hand in *Safety Car Heating and Lighting Company* v. *General Electric Company,* 155 F. 2d 937, 939-40 (2 Cir. 1946).

The Courts have consistently held that evidence of simultaneous solution of a problem by several independent workers is such as to "effectively refute" any suggestion that the solution was unobvious or involved invention. *Graham* v. *Jeoffroy Manufacturing,* 206 F. 2d 769, 771 (5 Cir. 1953):

> "The District Court, in holding the patent invalid for lack of invention and anticipation by the prior art, found that when the bending and breakage of the beams on the plows occurred, two individuals, Floyd W. Tyler and J. A. Robinson, independently and without any knowledge of the Graham device, developed and used an angular brace to reinforce their clamps and plow beams very similar to that of the patent in suit. In this connection, appellees concede that the Graham structure probably antedated the Tyler and Robinson developments and, therefore, that the latter may not be relied upon for the purpose of anticipating Graham. However, even though these developments admittedly do not rise to the dignity of patentable invention, we think they nevertheless remain significant as tending to reveal spontaneous and independent solutions of the problem without any knowledge of the Graham device by ordinary un-skilled farmers and laymen, and effectively refute appellant's claim that the Graham patent involved any invention, or anything beyond the skill of an ordinary workman or mechanic."

To the same effect, see *Thomson Company* v. *Ford Motor Company,* 265 U. S. 445, 452-53. And especially is this so when each of the several independent workers addressed himself to the problem, and quickly found the solution, only shortly after the need for a solution became apparent, as did Parker and Short in the case at hand. See *McElrath* v. *Industrial Rayon Corporation,* 123 F. 2d 627, 629 (4 Cir. 1941); *Fluor Corporation* v. *Gulf Interstate Gas Company,* 259 F. 2d 405, 407-08 (5 Cir. 1958); *J. R. Clark Company* v. *Murray Metal Products Company,* 219 F. 2d 313, 318 (5 Cir. 1955).

In the case under consideration, several persons who had occasion to address themselves to the manufacture of patterned, or textured, tufted carpet independently arrived at substantially the same device for doing so very shortly after the desire to have such a product arose. The facts are strikingly similar to those in the *Safety Car Heating and Lighting* case above referred to.

The foregoing discussion and cases cited therein appear applicable to the principal issue in the case under consideration, and after having considered the testimony, the exhibits and depositions, along with the briefs of both parties and the proposed findings of fact and conclusions of law (submitted by both parties), the Court hereby makes the following findings of fact and conclusions of law.

Findings of Fact

1.

Mohasco Industries, Inc., plaintiff, is a New York corporation having its principal place of business in Amsterdam, New York. Defendants are E. T. Barwick Mills, Inc., and Barwick Carpet Mills, Inc., a wholly-owned subsidiary, both Georgia corporations. There is no dispute as to juris-

diction and venue. Defendants are referred to as Barwick, as for the purpose of this case no distinction need be made between them.

2.

The complaint in this action, filed November 4, 1959, charges defendants with infringement of Odenweller Patent No. 2,853,032 and Crawford Patent No. 2,853,033, both of which issued to plaintiff on September 23, 1958, and are still owned by plaintiff. Plaintiff relies on Claims 1, 3, 6, 8, and 9 of Patent 2,853,032 and Claims 1, 3, 4, 5, 8, 10, and 11 of Patent 2,853,033, and alleges infringement thereof by defendants' manufacture and use of slat pattern attachments for the production of patterned tufted carpets. Defendants have denied infringement and allege that both patents in suit are invalid because the subject matter they purport to monopolize "would have been obvious at the time the invention was made to a person having ordinary skill in the art". Defendants have also counterclaimed for a declaratory judgment of invalidity and non-infringement on the same grounds.

3.

Odenweller Patent 2,853,032, entitled "APPARATUS FOR CONTROLLING PILE HEIGHT", is directed to a device, called a slat pattern attachment, for controlling the feed of yarns to the needles of a tufting machine, thus to control the height of pile loops created in the carpet made on the tufting machine. The pattern attachment consists of a pair of intermeshing gears which extend the full width of the tufting machine. The teeth on one of the gears are of uniform height, both with respect to one another and along their length, whereas the teeth or slats on the other gear are varied in height along their length in accordance with a desired pattern. The sheet of yarns to be fed to the tufting machine, one yarn for each individual needle, is passed

through the intermeshing zone between the variable-height teeth or slats carried on the surface of one gear and the fixed-height teeth on the surface of the other. When an individual yarn encounters a slat of low height, which, due to its low height, intermeshes only slightly with the teeth of the other gear, the amount of yarn taken up in the intermeshing will be small, a correspondingly small amount of feed will result, and because the height of the pile loops in the resultant fabric is dependent upon the amount of yarn feed, a low loop will result. If a yarn encounters a slat of full height, a greater amount of yarn is taken up in the intermeshing, a correspondingly greater amount of yarn is fed, and a high loop results in the fabric. Thus, a pattern of high and low loops, determined by the contour of the variable-height slats carried by one of the gears, is created in the pile fabric manufactured by the tufting machines.

4.

Crawford Patent 2,853,033, entitled "METHOD AND APPARATUS FOR FEEDING YARNS", is directed to a device which is the same in principle but differing in certain mechanical aspects from that of the Odenweller Patent 2,853,032. In the Crawford patent of variable-height slats and the fixed-height slats are mounted on endless chains rather than on the surface of cylindrical drums in the manner of gear teeth. Claims 4, 5, 8 and 10 of Patent 2,853,033 are directed to this apparatus, whereas Claims 1, 3 and 11 of this patent are directed to a method of feeding yarns through the use of this apparatus.

5.

The slat attachments of the patents in suit rely in their operation upon the principle that the height of the pile loops in tufted carpet can be controlled by restricting the

amount of yarn fed to the needles of a tufting machine. At the time the alleged inventions of the patents in suit were made, this principle was not new. Patent 2,876,441 to Boyles, covering this basic concept, was issued after a nine-party interference in the Patent Office which Odenweller and Crawford declined to join, thereby conceding that they had no basis for claiming authorship of this basic concept. Plaintiff does not contend that either patentee originated this principle of controlling pile height by controlling the rate of yarn feed. The application for the Boyles patent was filed in February, 1952, nearly two years prior to the work of either Odenweller or Crawford, and, hence, is prior art with respect to both patents in suit. The Boyles patent was not cited by the Patent Office against the applications for the two patents in suit.

6.

Prior to the time of the alleged inventions of the patents in suit, it was common practice to selectively produce high and low loops in tufted carpet, and thus achieve patterns in such carpets defined by the high and low pile loops, by the application of this principle of controlled yarn-feeding set out in Paragraph 5 above. The use of rollers to feed yarn was well known, and the manufacture of patterned tufted carpet was accomplished largely through the use of roller-type feeding attachments in which the yarns fed to the needles of a tufting machine were passed in contact (in the shape of a letter S) around and between a pair of feed rolls which could be driven at high or low speeds depending on whether a high or low loop was desired. Patterns were made with attachments of this sort by selectively varying the speeds of each of a number of rolls and thus creating high and low loops in accordance with a predetermined pattern.

Appendix B.

7.

Yarn-feeding devices known as furnishing wheels also were old and well known at the time the alleged inventions of the patents in suit were made. Yarn-furnishing wheels are nothing more than a pair of intermeshing gears wherein the yarn to be fed is passed through the intermeshing zone between the gears, the intermeshing causing undulations in the yarn. For a given speed of rotation of the gears, the amount of yarn released for each increment of rotation is directly proportional to the extent that one of the gears intermeshes with the other—a greater degree of intermesh releasing a longer length of yarn upon the disengagement of a pair of teeth and a smaller degree of intermesh releasing a shorter length of yarn. Yarn-furnishing wheels of this sort are disclosed by Patent 2,432,685 to Sawyer and Patent 2,247,245 to Lawson, neither of which was cited by the Patent Office against the applications for the two patents in suit.

8.

The patentee Odenweller, an employee of James Lees & Sons of Philadelphia, was the first to build a slat pattern attachment. Odenweller did his work in the fall of 1953, less than a year after he had first been exposed to tufting machines. The idea of applying the intermeshing principle to a pattern attachment for a tufting machine occurred to him while he was driving in his car to Bethlehem, Pennsylvania, to keep a date in October of 1953. Thereafter he did not immediately disclose his ideas to his superiors but kept them to himself for a time because he said he was "patent crazy", as was everyone else in the tufting industry. On January 8, 1954, Odenweller made a complete disclosure of his design to his superior at James Lees, which disclosure substantially conformed to the device shown in his patent in suit, No. 2,853,032. Shortly thereafter Lees

appropriated sufficient money to Odenweller for the construction of a model machine in accordance with his ideas, and he proceeded with plans to build a model. Later, on January 15, 1954, he submitted to his superiors at James Lees an amplification of his original disclosure. In this amplification he stated as a design alternative that the variable-height slats in his device might be carried by chains rather than drums. This is the substance of the Crawford patent in suit.

9.

The patentee Crawford's first exposure to commercial tufting machines came in the fall of 1953 after he had been assigned to work in the experimental department of Mohawk, corporate predecessor of the present plaintiff. In the spring of 1953, Mohawk had purchased a tufting mill in Laurinburg, South Carolina, and Crawford was sent there to work with the tufting machines, which were not operating properly. In Laurinburg, while working with tufting machines equipped with a single feed roll and intended to produce tufted carpet of plain pile height, Crawford first became aware of the principle that the control of yarn feed controls the height of pile tufts in tufted carpet. Shortly after his return to Amsterdam that fall, he devised his slat pattern attachment and, some time in early 1954, built a small model with slats about one inch wide carried by chains to test his theories. The model proved workable, so Crawford built a sample-sized slat attachment, and thereafter a full-sized slat attachment for use on a production tufting machine.

10.

Parker and Short were machine designers employed by Callaway Mills of LaGrange, Georgia. On June 20, 1955, Parker and Short were asked by Hans Lewis of Callaway's

Valway plant to look at a pattern attachment Callaway had purchased on trial from the Specialty Machine Company of Dalton, Georgia, to see if it could be made to operate properly. This Specialty attachment had rollers with abrasive surfaces and, although its principle was sound, it was not operating up to production standards because the abrasive surfaces on the rollers "fluffed up" the particular type of yarn they were trying to use with the attachment. Parker thought he could design a better feeding attachment, relying on the intermeshing principle, and by June 24th (4 days later), working in conjunction with his assistant, Short, he had reduced the height of a few teeth on one of a pair of gears and used these gears to feed a single yarn to the needle of an experimental tufting machine. These gears controlled the feed in such a way as to produce high and low loops. Thus fortified with confirmation of the thought that the intermeshing principle of furnishing wheels could be applied to feeding yarn to a tufting machine, Parker and Short felt they "had the problem licked", and so set out to design a sample attachment. In doing this, only a few days after having built and tested the gears, Parker and Short decided to use intermeshing slats carried by chains rather than gears in their design. Thereafter they built a model slat attachment employing intermeshing slats carried by chains, tested it and found it satisfactory, and began construction of a commercial-sized attachment. In a period of little more than a week after their first exposure to the problem, Parker and Short had "invented" the devices of both the Odenweller and Crawford patents.

11.

"Doc" Williams, President of Modern Tufting Company in Dalton, Georgia, made a single-strand slat pattern attachment in 1956 to determine whether or not the intermeshing principle could be applied to feeding yarns to a tufting ma-

chine. Williams' single-strand model proved successful, and thereafter he built a full-sized slat attachment and began using it in the production of tufted carpet in the fall of 1959.[3]

12.

Crawford, Parker and Short, and Williams, in devising their slat pattern attachments, built small models using intermeshing elements to control the feed of a single strand of yarn because they knew that if the intermeshing principle could be employed to control a single strand, it could be used to control as many strands as desired. The intermeshing principle of any slat attachment, whether the slats are carried by cylindrical drums or chains, is properly represented by a model capable of feeding a single strand. So represented, slat pattern attachments relying on the intermeshing principle differ from furnishing wheels only in that in the slat attachment the varying degree of intermesh is achieved by varying the height of the intermeshing elements, whereas in furnishing wheels it is achieved through varying the spacing of the centers of the gears.

13.

At the times that they made the devices set out in Paragraphs 8 through 11 above, Odenweller, Crawford, Parker and Short, and Williams were mutually unaware of one another and each did his work independently. They also were all unaware of furnishing wheels which rely upon the intermeshing principle to control yarn feed.

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[3] The Court heard evidence of Williams' work subject to objection of plaintiff that such work was not contemporaneous within the meaning of the statute, Section 103, and therefore irrelevant. This Court holds the evidence of Williams relevant and admissible. See *Safety Car Heating & Lighting Company* v. *General Electric Company*, 155 F. 2d 937, 939-940.

Appendix B.

14.

It would have been obvious to a person of ordinary skill in the tufting art to control the feed of yarn to the needles of a tufting machine, to achieve patterns defined by high and low loops in accordance with Boyles' old and well known controlled-feed principle, through the use of the old and well known intermeshing principle of furnishing wheels.

15.

The fact that each of four different persons or groups of persons was able to devise slat pattern attachments as soon as the desire to make them manifested itself is a well-nigh conclusive demonstration that to make such an attachment not only would have been, but in fact was, obvious to persons having ordinary skill in the art. Indeed, the fact that each of the persons who accomplished this was without knowledge of the most pertinent prior art—furnishing wheels—makes it much more conclusive that the result would have been obvious to a person having this knowledge, which is imputed by law to be a hypothetical man skilled in the art to whom a device must be unobvious to meet the statutory requirement for patentability.

16.

The Boyles patent, basic to the concept of forming high and low loops in tufted fabric by controlling the feed of yarn to the needles of a tufting machine, contemplates the formation of low loops by the withdrawal or "robbing" of yarn from the previously formed loop as the needles of the tufting machine descend to form the next loop. Because it was in fear of a charge of infringement of the Boyles patent, Mohasco sought and obtained another patent, Crawford 2,853,034 (not in suit), disclosing and claiming an alternative to the Boyles technique, which alternate contemplates forming low loops by withdrawing yarn from the loop just

formed instead of robbing yarn from the previously formed loop. Mohasco thought and hoped that this alternative to loop-robbing provided the means to avoid infringement of the Boyles patent.

17.

An interference was declared in the Patent Office between applications for patents which were filed on behalf of Odenweller, Crawford, and Parker and Short. That interference was settled by an agreement among the parties which was precipitated by the fact that Mohasco held title to the application for the Crawford '034 patent, not involved in the interference, which seemingly offered a way to avoid a charge of infringement based upon the prior and adversely-held Boyles patent. James Lees and Callaway, the owners of the Odenweller and the Parker and Short applications, respectively, agreed to assign their applications to Mohasco and received in exchange free licenses under the applications involved in the interference and the additional application owned by Mohasco. Lees and Callaway were motivated to settle the interference and give Mohasco title to the Odenweller and Parker and Short applications, primarily to obtain the right to use the alternative to loop-robbing of Crawford '034. The circumstances of this settlement, together with the circumstances of the filing of the application for Crawford's '034 patent mentioned in Paragraph 16 above, minimize the importance of the patents in suit compared with that which was attributed (whether rightly or wrongly) to Crawford's '034 patent.

18.

After this settlement of the interference mentioned in Paragraph 17 above, Mohasco undertook to offer licenses to the tufting industry under its Odenweller, Crawford

'033, and Crawford '034 patents. In these offers Mohasco emphasized that its patent to Crawford, 2,853,034 (not to be confused with Crawford Patent 2,853,033 in suit) offered a way to avoid the Boyles patent and, as an added inducement, agreed in its standard license contract to hold its licensees harmless in any suit on the Boyles patent. Licenses were taken by about thirteen tufters, out of about eighty in the industry as a whole. But, to whatever extent Mohasco's licensees considered patents at all, they were motivated to take a license by the indemnity against suit on the Boyles patent which Mohasco offered them. None of plaintiff's licensees was motivated to take a license by the strength of the patents here in suit, 2,853,032 and 2,853,033. The licensees whose testimony was offered at the trial stated that they had made no inquiry into the scope or validity of these patents, but had taken their licenses either (1) simply to get the attachment from Mohasco, the only source from which it was then available, or (2) if they considered patents at all, to take advantage of the 2,853,034 patent's avoidance of the Boyles patent and its accompanying indemnity. Furthermore, most of plaintiff's licensees, representing only a small segment of the tufting industry, were small manufacturers having neither the means nor the inclination to engage in a legal battle with Mohasco to test the validity of Mohasco's patents. Under these circumstances, the licenses are no tribute to the patents in suit.

19.

When the Boyles patent issued, it was owned by a Georgia patent holding company called Tufted Patterns, Inc. Barwick, by virtue of its interest in a patent to Nix, a Barwick employee, obtained a free license under all of the Tufted Patterns patents, including the Boyles patent. In the summer of 1960, the Boyles and related patents

were sold by Tufted Patterns to Singer-Cobble, a large manufacturer of tufting machines and related equipment, the agreement of sale reciting the existence of the Barwick license. Singer-Cobble threatened Mohasco and its licensees with suit for infringement of the Boyles patent and Mohasco brought suit against Singer-Cobble for a declaratory judgment of invalidity of the Boyles patent. This suit was settled by an agreement between Mohasco and Singer-Cobble, by which Mohasco agreed to pay over to Singer-Cobble 50 percent of most of the royalties it had theretofore received under its licenses and 60 percent of all royalties to be received on future licenses. This agreement testifies to the value attributable in these licenses to the Crawford '034 patent (the supposed way to avoid Boyles) on the one hand and the patents in suit on the other. It further demonstrates that the licenses taken from Mohasco involve no recognition of validity or tribute to the patents in suit.

20.

In the decade between 1952 and 1962 the tufting industry enjoyed enormous growth. In 1952 tufted carpets amounted to only about 7 percent of all carpets produced, whereas in 1962 they amounted to nearly 80 percent. This growth in the tufting industry is attributable to a variety of factors which combined to take tufted carpets out of the category of "sleazy" products and enabled them to compete on a quality basis with woven floor coverings. These factors include the use of jute backings, roller coated latex backings, and double jute backings to give tufted products dimensional stabilty and the feel of quality; improved dyeing techniques, making possible rapid and economic coloring of tufted carpets; and, perhaps most importantly, improved pile fibers, both natural and synthetic. The abilty to produce patterned tufted carpets, afforded by the various types of pattern attachments in use, also con-

tributed in some measure to this growth, but to a lesser extent than any of the factors mentioned above. In the Barwick organization the demand for patterned tufted carpet is decreasing, and in 1962 Barwick's business in patterned carpet was off 1½ million dollars from the previous year.

21.

Slat pattern attachments of the sort the patents in suit purport to monopolize have found some use in the tufting industry but they have not taken the place of pattern attachments relying on the roller principle. Altogether about eighty-five slat attachments are in use in the tufting industry today. In contrast with this, there are about three hundred and forty roller attachments in use, nearly four times as many. About one hundred and fifty 6- or 7-roll pattern attachments, the first and the most rudimentary of the roll-type attachments, have been sold and are in use in the industry. By subsequent refinement, so-called "scroll" attachments, having from sixty to one hundred and twenty rolls, have been devised and have found increasing acceptance in the tufting industry; over one hundred of these attachments have been sold since 1958, and their use is increasing. Universal attachments, which rely on a variant of the basic roller principle in which each yarn is laterally switched from a high or low speed roll, depending on whether the high or low loop is desired, have also been widely used and about ninety of these attachments, manufactured by Singer-Cobble, are in use in the industry today. Other attachments of the same sort, but differing in mechanical detail, are used by other companies, such as Cabin Crafts.

22.

There was no long-felt want for slat pattern attachments in the tufting industry. The various roll-type attach-

ments mentioned in Paragraph 21 above were perfectly adequate to satisfy the demand for patterned tufted carpet, as evidenced by the fact that Lees, Odenweller's employer, though in possession of his model slat attachment and assured of its operability in 1954, elected to make its best-selling carpet on a 6-roll attachment and did not build a slat attachment until 1960. Similarly, Mohasco, Crawford's employer, purchased and used a 6-roll attachment after he had devised and proved his slat attachment. The experience of others in the industry is similar, and these experiences combine to demonstrate that the slat pattern attachment was neither devised to satisfy a long-felt demand nor did it achieve immediate acceptance to the exclusion of other devices capable of performing the same job after it was devised.

23.

Barwick's first sample-sized slat attachment was designed in the fall of 1957, nearly a year before Mohasco's patents issued, by Joe Nix, a Barwick Vice President, and two engineers working under him. This work was done without any knowledge of Odenweller and Crawford or their work, but Nix had some knowledge of Parker and Short's slat attachments which he had obtained from E. F. O'Neal, a former Callaway employee who was then assistant manager of Barwick's Dalton plant. While at Callaway, O'Neal had obtained a general understanding of the operation of Parker and Short's slat attachment and, since Callaway had made no effort to keep it secret, he felt no hesitancy about passing this information on to Nix. After the sample-sized attachment proved workable, Barwick built a full-sized slat attachment, which went into production in June, 1958, several months before the Mohasco patents issued. Thereafter, additional slat attachments were made and put into production.

Appendix B.

24.

In the fall of 1958 plaintiff's patents issued. In May of 1959, Llewellyn, Mohasco's Manager of Merchandise Development, wrote to Mr. Barwick, calling attention to the Mohasco patents and suggesting a license. Mr. Barwick turned the matter over to Nix who, by virtue of his participation in the Tufted Patterns enterprise, was acquainted with the patent situation, both with respect to Tufted Patterns and Mohasco. Nix and other Tufted Patterns principals, including George Hopkins and Edward Taylor Newton, Atlanta patent attorneys, had been considering the patent situation at some length ever since the Mohasco patents had issued, and had concluded that the methods used by Barwick were considerably different from those the Mohasco patents purported to monopolize. On the advice of Nix and his Tufted Patterns associates, Barwick responded to Llewellyn's letter with the contention that Barwick's process was different from anything claimed in the patents. Mohasco was not satisfied with this response and this litigation followed.

25.

A major difference in mode of operation exists between the slat pattern attachments disclosed and claimed in both patents in suit and those used by Barwick. Both patents require in their specification that their slat attachments be operated in synchronism with the needles of the associated tufting machine—in such a manner that one full wave of yarn gripped between intermeshing slats is released for each needle stroke. The specifications of the patents emphasize this as an essential mode of operation, and plaintiff's witnesses, Crawford and Lawrence, both testified at length as to the importance of this feature. Barwick's slat attachments do not operate in this way. In

Barwick's attachment the amount of yarn released for each stroke of the needles of the tufting machine may and does vary from less than a full wave to more than a full wave—Barwick makes no effort whatever to synchronize the release of yarn with the needle strokes. If a Barwick machine were ever operated with the release of yarn and the needle strokes in synchronism, it would be purely by chance and without significance to the operation.

Conclusions of Law

1.

This Court has jurisdiction over the parties and over the subject matter of this action and defendants' counterclaim seeking a declaratory judgment of invalidity.

2.

United States Letters Patents Nos. 2,853,032 and 2,853,033, the patents in suit, issued to plaintiff on September 23, 1958, and were owned by plaintiff on November 4, 1959, when the complaint in this action was filed.

3.

Patents Nos. 2,853,032 and 2,853,033 are entitled to no presumption of validity over the prior art relied upon by defendants which was not cited or considered by the Patent Office; their presumption of validity is further diminished by the fact that the interference in which they were involved was settled by agreement rather than decided by the Patent Office.

4.

Claims 1 to 9, inclusive, of Patent 2,853,032 and Claims 1 to 12, inclusive, of Patent 2,853,033 are each invalid and

void for lack of any patentable invention over the prior art because they define nothing more than an obvious use of the intermeshing principle of yarn-furnishing wheels as illustrated by the patents to Sawyer, 2,432,685, and Lawson, 2,247,245, a use which would have been obvious to a man of ordinary skill in the tufting art at the time the alleged inventions were made.

5.

Plaintiff has failed to prove infringement of Claims 1, 3, 6, 8, and 9 of Patent 2,853,032 and Claims 1, 3, 4, 5, 8, 10, and 11 of Patent 2,853,033, the only claims plaintiff has charged defendants with infringing.

6.

Defendants, E. T. Barwick Mills, Inc., and Barwick Carpet Mills, Inc., are entitled to judgment against plaintiff, Mohasco Industries, Inc., dismissing the complaint with prejudice, adjudging all claims of Patents Nos. 2,853,032 and 2,853,033 invalid and not infringed and with taxable costs to defendants.

JUDGMENT

In accordance with the foregoing findings of fact and conclusions of law, it is hereby ORDERED, ADJUDGED AND DECREED that

1.

Claims 1 to 9, inclusive, of United States Letters Patent No. 2,853,032 are, and each of them is, invalid and void in law.

2.

Claims 1 to 12, inclusive, of United States Letters Patent No. 2,853,033 are, and each of them is, invalid and void in law.

Appendix B.

3.

Claims 1 to 9, inclusive, of United States Letters Patent No. 2,853,032 have not been infringed by defendants.

4.

Claims 1 to 12, inclusive, of United States Letters Patent No. 2,853,033 have not been infringed by defendants.

5.

Plaintiff's complaint for infringement of said Letters Patent is hereby dismissed with prejudice, and plaintiff shall take nothing by its complaint.

6.

Defendants, E. T. Barwick Mills, Inc., and Barwick Carpet Mills, Inc., shall have and recover from plaintiff, Mohasco Industries, Inc., their taxable costs.

This the day of , 1963.

LEWIS R. MORGAN,
United States District Judge.

Appendix B.

Opinion of Court of Appeals

IN THE

UNITED STATES COURT OF APPEALS

FOR THE FIFTH CIRCUIT

No. 20966

MOHASCO INDUSTRIES, INC.,

Appellant,

versus

E. T. BARWICK MILLS, INC. and
BARWICK CARPET MILLS, INC.,

Appellees.

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE NORTHERN DISTRICT OF GEORGIA.

(January 22, 1965.)

Before WISDOM and GEWIN, Circuit Judges, and BREWSTER, District Judge.

PER CURIAM: Mohasco Industries, Inc., the plaintiff below, complains of the judgment of the United States District Court for the Northern District of Georgia in favor of appellees (defendants) in an action for patent infringement. The trial court held that the patents in issue were invalid and void and not infringed by the defendants. We are in agreement with the result reached by the trial court. *Mohasco Industries, Inc.* v. *E. T. Barwick Mills, Inc.*, 221 F. Supp. 191 (1963). The judgment is AFFIRMED.

Appendix B.

Judgment of Court of Appeals

UNITED STATES COURT OF APPEALS

FOR THE FIFTH CIRCUIT

OCTOBER TERM, 1964

No. 20966

D. C. Docket No. 7000—Civil Action

MOHASCO INDUSTRIES, INC.,

Appellant,

versus

E. T. BARWICK MILLS, INC. and
BARWICK CARPET MILLS, INC.,

Appellees.

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE NORTHERN DISTRICT OF GEORGIA.

Before WISDOM and GEWIN, Circuit Judges, and BREWSTER, District Judge.

JUDGMENT

This cause came on to be heard on the transcript of the record from the United States District Court for the Northern District of Georgia, and was argued by counsel;

ON CONSIDERATION WHEREOF, It is now here ordered and adjudged by this Court that the judgment of the said District Court in this cause be, and the same is hereby, affirmed;

It is further ordered and adjudged that the appellant, Mohasco Industries, Inc., be condemned to pay the costs of this cause in this Court for which execution may be issued out of the said District Court

January 22, 1965

Issued as Mandate:

Appendix B.

Court of Appeals Order Denying Rehearing

IN THE

UNITED STATES COURT OF APPEALS

FOR THE FIFTH CIRCUIT

No. 20966

MOHASCO INDUSTRIES, INC.,

Appellant,

versus

E. T. BARWICK MILLS, INC. and
BARWICK CARPET MILLS, INC.,

Appellees.

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE NORTHERN DISTRICT OF GEORGIA.

(March 18, 1965.)

ON PETITION FOR REHEARING

Before WISDOM and GEWIN, Circuit Judges, and BREWSTER, District Judge.

PER CURIAM: In petition for rehearing appellant takes us to task for use of the words in our opinion that we are in agreement "with the result reached by the trial court," and concludes that we have held by implication that some of the findings of the trial court were clearly erroneous and that we may have disapproved of rules of law applied by the trial court. Such interpretation is incorrect. We consider the opinion of the District Court sufficiently informative, and a correct disposition of the issues presented.

Accordingly, IT IS ORDERED that the petition for rehearing be, and the same is hereby DENIED.

APPENDIX C

The History of the Four Inventors

Odenweller

In early 1953, Odenweller's employer, James Lees and Sons, a well known carpet company, was producing patterned tufted carpet by the use of a six-roll attachment and was dissatisfied with the simple patterns obtainable (II 888, 891). The company, accordingly, engaged an outside consultant and organized a team of its engineers including Odenweller for the purpose of devising an attachment which would give independent control of individual pile yarns and produce elaborate floral patterns (II 891-2). The group of engineers had numerous meetings but their efforts resulted only in the design of another form of roll attachment which was built but never went into production (II 908-911). After months of further thought, Odenweller conceived the drum and pinion form of the slat attachment late in 1953 (II 945) and filed his patent application in April, 1954. Odenweller and his associates were thus unable to devise the slat attachment "as soon as the desire . . . manifested itself" (App. B p. 23a) and did not resort to the slat attachment as the obvious solution of their problem.

Crawford

Crawford attempted to solve the problem of producing patterned tufted goods with the individual pile yarns under independent control in late 1952 (I 374) and his proposed solution of the problem at that time was the modified tufting machine shown in his patent 2,850,994 (IV 1819). The machine was theoretically capable of providing independent control of individual pile yarns (II 544) but it was never built (I 383). The machine did not employ intermeshing slats or any similar means for feeding pile yarns at varying rates. In late 1953, Crawford conceived the slat attachment

with the slats mounted on chains (I 388-9) and completed his invention by filing the application for the '033 patent in suit in July, 1954. Crawford's first effort to provide independent pile yarns control was a failure and did not involve intermeshing notched slats. He thus did not invent the slat attachment "as soon as the desire" arose (App. B p. 23a) but about a year later.

Parker and Short

In late 1953 or early 1954, Callaway Mills Company was producing patterned tufted goods by the use of a roll attachment and was dissatisfied with the limited variety of patterns obtainable (III 1042). Accordingly, the Callaway management asked Parker,* the head of the company's mechanical research department (III 955), and his assistant, Short, to develop a pattern attachment which would provide independent control of the individual yarns being fed to a tufting machine (III 1042). In compliance with the request, they built an attachment bearing no resemblance to a slat attachment and of great complexity. The attachment so reduced the speed of the tufting machine with which it was used, that the management would not use it and it was discarded (III 1044-8).

In June, 1955, about 18 months after Odenweller and Crawford had conceived the slat attachment, Parker and Short inspected a pattern attachment which had been purchased by Callaway Mills on a trial basis and was not working well (III 1029). The inspection led to a second attempt by Parker and Short to devise an attachment which would give independent control of individual yarns and, after a number of days of thought, Parker conceived the

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* Parker is a highly skilled inventor who is sole or joint patentee of about 25 inventions, most of which went into commercial use (III 1019).

slat attachment. Thus, when Parker and Short were first faced with the problem of providing independent control of individual yarns being fed to the needles of a tufting machine, they did not immediately invent the slat attachment; their invention of that attachment was on their second attempt 18 months after their first failure.

Williams

In late 1950, Williams, president of Modern Tufting Company* (III 1055), accidentally produced tufted carpet with a pattern of high and low loops in the pile as a result of a defect in the feed roll of the tufting machine (III 1168). He recognized the pattern in the goods and, in January, 1951, he modified the machine to afford better control of the pile yarns being fed (III 1168-9). From the start, Williams was not satisfied with the simple patterns which could be produced and he tried "different ways and methods" (III 1181) of obtaining better yarn control. He wanted to control the individual pile yarns (III 1180) and, in the early '50's, experimented with gears for feeding the yarns (III 1200). However, it was not until late 1957 or early 1958 that Williams conceived the slat attachment and built a one-yarn model (III 1157). Williams' invention of the slat attachment was thus not made "as soon as the desire to make them manifested itself" (App. B p. 23a) but about seven years later.

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* Williams is a highly ingenious man who has received patents on a fringing machine and a tufting machine and has made about 50 developments in tufting machines and processes which have gone into use in his and other factories (III 1117-20).

MOTION FILED

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SUPREME COURT, U. S.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No. 253

MOHASCO INDUSTRIES, INC.,

Petitioner,

vs.

E. T. BARWICK MILLS, INC.,

and

BARWICK CARPET MILLS, INC.,

Respondents.

MOTION FOR LEAVE TO SUPPLEMENT PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No. 253

MOHASCO INDUSTRIES, INC.,

Petitioner,

vs.

E. T. BARWICK MILLS, INC.,

and

BARWICK CARPET MILLS, INC.,

Respondents.

MOTION FOR LEAVE TO SUPPLEMENT PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

Now comes the petitioner, Mohasco Industries, Inc., and respectfully moves this Court for leave to supplement the petition for certiorari filed herein by adding as an appendix thereto the copy of the decision printed as the appendix to this motion. The reasons why the motion is being filed and why it should be granted are as follows.

The petition was filed on June 14, 1965, and one of the questions presented involves the propriety of the filing by the District Court of an opinion, which is, with minor changes and omissions, a verbatim copy of the introductory part of a pre-trial memorandum filed by respondents months before the trial and the adoption by the District Court, with insignificant changes or none, of findings of fact, conclusions of law, and a judgment prepared by re-

spondents. The question further involves the propriety of the sanctioning by the Court of Appeals in an unenlightening Per Curiam opinion four sentences long of the opinion, findings, conclusions, and judgment of the District Court with the result that petitioner has never had the benefit of the independent judicial thought of either court and the opinions and findings contain cogent evidence that neither court made the painstaking study of the record, to which petitioner was entitled.

From advance sheets dated June 9, 1965, petitioner learned for the first time on June 16, 1965, of the decision in *Roberts* v. *Ross*, 9 FRS 2d 789 (3 Cir. April 29, 1965), of which a copy appears in the appendix to this motion. The *Roberts* decision is pertinent to the present case, in that it contains a strong condemnation of the trial court because of its mechanical adoption of findings of fact and conclusions of law prepared by counsel for the prevailing party and points out at length the evils of such a practice. In *Roberts*, the Court of Appeals vacated the judgment and remanded the cause for "appropriate findings of fact and conclusions of law after a complete re-examination of the evidence and in the light of the appropriate legal principles." If petitioner had known of the *Roberts* decision prior to the filing of the petition herein, reference to the decision would have been made in the petition and the decision would have been printed as an appendix to the petition. Since the *Roberts* decision should be considered by this Court in acting on the petition, it is respectfully requested that this motion be granted.

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APPENDIX

Roberts v. Ross

US Court of Appeals, Third Circuit, April 29, 1965
9 FR Serv2d 52a.11, Case 1; —— F2d ——

52a.11 [52a.42, 52a.43] **Adequacy of findings and conclusions prepared by counsel.**

The practice by trial judges of announcing their decision for the plaintiff or the defendant substantially in the form of a general verdict, and of thereupon directing counsel for the prevailing party to prepare and submit findings of fact, conclusions of law, and a form of judgment, is disapproved. It not only imposes a well-nigh impossible task upon counsel but also flies in the face of the spirit and purpose, if not the letter, of Rule 52(a). Findings and conclusions prepared by a party and adopted by the trial judge without a change are likely to be looked at by the appellate court more narrowly and given less weight on review than if they are the work product of the judge himself or at least bear evidence that he has given them careful study and revision.

52a.43 [52a.45] *Adequacy of findings and conclusions by court.*

In action to recover a stated sum which plaintiff alleged defendant had promised to pay him for services rendered in producing a buyer for defendant's house, conclusion that "plaintiff has failed to prove by a preponderance of the evidence that the sale of said property by the defendant was procured by the agency of plaintiff" was inadequate where there was no finding as to whether the defendant agreed to pay the plaintiff a commission for the sale of the property, a question which was the crucial issue in the case. The trial judge's conclusion afforded the appel-

late court no indication of the legal standard under which the evidence was considered.

58.14 [58.32] *Entry of judgment as of course.*

Where the trial judge decided the case in favor of defendant and dismissed the action, Rule 58 required the clerk to enter the judgment for the defendant forthwith pursuant to the court's decision; the court's request to counsel to prepare a draft of judgment was neither required nor appropriate.

Appeal from the District Court of the Virgin Islands, Division of St. Thomas and St. John. Before MARIS, MCLAUGHLIN and FREEDMAN, Circuit Judges.

MARIS, Circuit Judge. The plaintiff, Herbert J. Roberts, appeals from a judgment entered in the District Court of the Virgin Islands dismissing his action brought to recover the sum of $3,087.50 which he alleged the defendant Norman M. Ross, Jr. promised to pay him for services rendered in producing a buyer for a dwelling house which the defendant had built in St. Thomas. The defendant answered, denying any such promise and, subsequently, with leave of court, he filed an amended answer in which he interposed the special defense of the Statute of Frauds.

On May 21, 1963 the case was tried to the court. The testimony given at the trial was sharply conflicting. The plaintiff, who was employed by the defendant as a foreman in connection with the construction by the defendant of a dwelling house on Parcel 1-14, Estate St. Joseph and Rosendahl, St. Thomas, testified that in December 1961 the defendant promised him a 5% commission of the sale price if he "sold the house." The plaintiff brought one James Soutter, who was in the market for a home, to see the house and introduced Soutter to the defendant. The

plaintiff had quoted $65,000 as the sale price to Soutter. Thereafter, Soutter and the defendant negotiated for the purchase of the house. They agreed upon the price of $61,750.00, an agreement of sale was drawn up on March 5, 1962 and a deed was executed on May 1st. The plaintiff testified that following the sale of the house, the defendant offered to pay him a commission of 2½% of the sale price which he refused and subsequently the defendant offered him a percentage which would have amounted to several hundred dollars which he also refused. The plaintiff, who had left the Virgin Islands in July 1962 for the United States, received a letter from the defendant under date of August 28, 1962 notifying him that the defendant had "laid off all of the crew" including the plaintiff. Then, under date of August 31st, the plaintiff wrote the defendant stating, inter alia, "The thing that bothers me is that you have never mentioned the commission for selling the house."

Soutter, the purchaser, testified that the plaintiff brought him to the house and that Soutter had never discussed the purchase of the property with any real estate broker. When the final price was being discussed with the defendant, Soutter was given the impression that payment of a commission would be made to plaintiff, but he had no idea as to the amount.

The defendant testified that he did not make the plaintiff any offer of a commission or a promise of any amount for bringing about the sale to Soutter and that the first time the plaintiff made a demand for a commission on the sale was in the letter of August 31st. The defendant further testified as follows:

> "A. We had one discussion about a commission. I told Herb [the plaintiff] the day before I was going down to sign the contract of sale that I was going to Cox's office the next morning to meet Mr. Soutter and

sign it, and at that time he said 'Am I going to get a commission on the house?' and I said 'I don't think so.'

"Q. That was all the discussion?

"A. That was all. He approached me with the idea himself. I could see no reason why he should get a commission. He wasn't a broker. He was an employee of mine. The next day when I talked with Mr. Soutter I asked him about a commission. I said 'Herby expects a commission' and Soutter says 'He does not deserve a commission. He is a friend, he is an employee of yours, and he is not a broker, and I'm not going through a broker, so I see no reason why he should get a commission.'

"Q. And that's why you dropped the price from—

"A. From $65,000 to $61,750."

On December 30, 1963, the trial judge entered an order stating that he had found for the defendant on the issues presented and directing counsel for the defendant within 10 days to file proposed findings of fact, conclusions of law and draft of judgment. Counsel for the plaintiff was given leave within 10 days thereafter to file objections thereto, which he did. On January 14, 1964 the findings of fact, conclusions of law, and judgment prepared and filed by counsel for the defendant were signed by the trial judge without change. It was concluded as a matter of law that "plaintiff has failed to prove by a preponderance of the evidence that the sale of said property by the defendant was procured through the agency of plaintiff," and that "in any event, said alleged promise not being in writing is within the Statute of Frauds." The plaintiff appealed from the judgment entered thereon dismissing his complaint.

. . . . . .

[52a.43, 52a.45] The defendant further argues that, even assuming that the action is not barred by any statute,

the plaintiff failed to prove the alleged agreement by a preponderance of the evidence, and the trial judge was accordingly justified in concluding that any discussion relating to compensating plaintiff for alleged sale of the property was at most the offer of a gratuity on the part of the defendant not specifically enforceable for indefiniteness. The fallacy in defendant's argument is that the trial judge failed to make any such findings. There is no finding as to whether the defendant agreed to pay the plaintiff a commission for producing a customer for the sale of the property —a question which was the crucial issue in the case. And there is no support in the record for the conclusion as a matter of law that "plaintiff has failed to prove by a preponderance of the evidence that the sale of said property by the defendant was procured through the agency of plaintiff." For it was undisputed that the plaintiff brought Soutter to the property and introduced him to the defendant as a prospective purchaser. Perhaps the term "agency" in the quoted conclusion is intended to mean that the plaintiff, in doing so, did not act as agent for the defendant, thus possibly implying that the defendant did not agree to pay plaintiff a commission if he produced a buyer for the property. The trial judge's conclusion is, however, so inadequate as to afford this court no indication of the legal standard under which the evidence was considered.

This court has had occasion to point out that Rule 52(a) of the Federal Rules of Civil Procedure requires the trier of the facts to find the fact specially and state his conclusions of law thereon with clarity. The findings of fact and conclusions of law must be sufficient to indicate the bases of the trial judge's decision. Kruger v. Purcell, 3 Cir 1962, 4 VI 361, 300 F2d 830; Island Construction Corporation v. Danielson, 3 Cir 1963, 4 VI 426, 431, 316 F2d 161, 163. The findings and conclusions in the present case do not meet this requirement.

[52a.11] Moreover we have observed in this case and in a number of others which have been brought here from the district court for review that the judge of the court has followed the practice of announcing his decision for the plaintiff or the defendant substantially in the form of a general verdict, either in a written order or by communication to counsel, and of thereupon directing counsel for the prevailing party to prepare and submit findings of fact, conclusions of law and a form of judgment. The trial judge's order has not been accompanied by an opinion setting out, even summarily, the facts and legal conclusions which have brought him to his decision. Obviously the judge must have dealt with the questions of fact and law involved in the case in the course of the reasoning by which he has reached his ultimate conclusion, even though his reasoning has not been articulated and put on paper. But counsel who is called upon to articulate and write out the findings and conclusions must do so without any knowledge of the fact findings and reasoning processes through which the judge has actually gone in reaching his decision.

We strongly disapprove this practice. For it not only imposes a well-nigh impossible task upon counsel but also flies in the face of the spirit and purpose, if not the letter, of Rule 52(a). The purpose of that rule is to require the trial judge to formulate and articulate his findings of fact and conclusions of law in the course of his consideration and determination of the case and as a part of his decision making process, so that he himself may be satisfied that he has dealt fully and properly with all the issues in the case before he decides it and so that the parties involved and this court on appeal may be fully informed as to the bases of his decision when it is made. Findings and conclusions prepared ex post facto by counsel, even though signed by the judge, do not serve adequately the function contemplated by the rule. At most they provide the judge with an opportunity to reconsider the bases of his original de-

cision but without affording the parties any information as to what those bases were or which of them are being reconsidered. At worst they are likely to convict the judge of error because, as here, they are inadequate to support his decision or because, as we have observed in other cases, they are loaded down with argumentative over-detailed partisan matter much of which is likely to be of doubtful validity or even wholly without support in the record.

[52a.42] In Mesle v. Kea Steamship Corporation, 1958, 260 F2d 747, 750, this court, speaking through Judge McLaughlin, pointed out that we disapprove the practice of a trial judge adopting findings of fact and conclusions of law prepared by counsel for the prevailing party. We did not then, and do not now, mean to suggest that a trial judge should not have the right to invite counsel for both parties to submit to him proposed findings of fact and conclusions of law, accompanied by briefs if he desires them, to assist him in formulating his own findings and conclusions and reaching his decision. In the process of studying the facts and the law, findings and conclusions formulated and proposed by the parties may be most helpful to the judge in sharpening the issues and may serve a very useful purpose in aiding him in drafting his own findings and conclusions.[3] In most cases it will appear that many of the findings proposed by one or the other of the parties are fully supported by the evidence, are directed to material matters and may be adopted verbatim and it may even be that in some cases the findings and conclusions proposed by a party will be so carefully and objectively prepared that they may all

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[3] See the excellent discussion of the subject by the Court of Appeals for the Second Circuit in The Jemson No. 1, 1941, 123 F2d 999, 1001. See also the illuminating discussion by Judge Gunnar H. Nordbye, Improvements in Statement of Findings of Fact and Conclusions of Law, 1940, 1 FRD 25, 30, and Judge J. Skelly Wright, The Nonjury Trial—Preparing Findings of Fact and Conclusions of Law, Seminars for Newly Appointed United States District Judges, West Pub Co, 1963, pp 159, 166.

properly be adopted by the trial judge without change.[4] But it should be remembered that findings and conclusions prepared by a party and adopted by the trial judge without change are likely to be looked at by the appellate court more narrowly and given less weight on review than if they are the work product of the judge himself or at least bear evidence that he has given them careful study and revision.[5] For the latter procedure would assure the appellate court, as Judge Wisdom pointed out in Louis Dreyfus & Cie. v. Panama Canal Company, 5 Cir, 1962, 298 F2d 733, 738, "that the trial judge did indeed consider all the factual questions thoroughly and would guarantee that each word in the finding is impartially chosen." It has been the general practice of the district judges of the Third Circuit in the past under Rule 52(a) to formulate their findings of fact and conclusions of law in the course of and as a part of their decision-making process and to articulate and file them at the time of announcing the decision, either in an opinion if filed at that time[6] or in a separate document. For the reasons set out in this opinion we strongly approve this practice and direct it to be followed in the future by the court below.

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[4] Most of the reported cases which have approved findings and conclusions which the trial judge has adopted in the form prepared by counsel without change involve findings and conclusions submitted before decision. And in many of the cases which involve findings and conclusions submitted after decision the trial judge filed an opinion or memorandum decision which outlined his findings and conclusions and thus afforded counsel information from which to formulate detailed findings and conclusions for him.

[5] Kinnear-Weed Corp. v. Humble Oil & Refining Co., 5 Cir 1958, 259 F2d 398, 400-401; Mesle v. Kea Steamship Corporation, 3 Cir 1958, 260 F2d 747, 750.

[6] The practice of including the findings of fact and conclusions of law in the opinion filed is specifically authorized by Rule 52(a) as amended, and is a useful practice in many cases.

[58.14, 58.32] The procedure for the entry of judgment involves other considerations which require brief discussion. The judgment obviously cannot be formulated until the case has been decided. Rule 58, as amended, provides, so far as here pertinent, that upon a decision by the court that a party shall recover only a sum certain or costs or that all relief shall be denied, the clerk, unless otherwise ordered, shall forthwith prepare, sign, and enter the judgment *without awaiting any direction by the court.* If the decision grants other relief the court shall promptly approve the form of judgment and the clerk shall enter it. *Every judgment must be set forth on a separate document.* Forms of judgment shall not be submitted by counsel unless directed by the court and *these directions shall not be given as a matter of course.* It will thus be seen that in the present case the rule required the clerk to enter the judgment for the defendant forthwith pursuant to the court's decision and that the request to counsel to prepare it was neither required nor appropriate.

Since, as we have seen the findings prepared by counsel, and which the trial judge adopted without change, are inadequate in that findings necessary to support the judgment are lacking, the judgment must be vacated and the cause remanded for appropriate findings of fact and conclusions of law after a complete reexamination of the evidence and in the light of the appropriate legal principles.

The judgment of the district court will be vacated and the cause remanded for further proceedings not inconsistent with this opinion.

[Compare the decision of the Supreme Court in United States v. El Paso Natural Gas Co., 376 US 651, 8 FR Serv2d 52a.11, Case 1 (April 6, 1964).—Ed.]

Office-Supreme Court, U.S.
FILED
JUL 15 1965
JOHN F. DAVIS, CLERK

IN THE

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MOHASCO INDUSTRIES, INC.,
Petitioner,

vs.

E. T. BARWICK MILLS, INC.,
and
BARWICK CARPET MILLS, INC.,
Respondents.

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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July 15, 1965

The patents in suit are:

Odenweller No. 2,853,032	(IV 1413)
Crawford No. 2,853,033	(IV 1418)

The opinions of the Courts below:

District Court Opinion, 221 F. Supp. 191-205	(Petitioner's Appendix B, pp. 4a-33a)
Court of Appeals Opinion, 340 F. 2d 319	(Petitioner's Appendix B, p. 34a)
Court of Appeals denial of rehearing, 342 F. 2d 431	(Petitioner's Appendix B, p. 36a)

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Appendix B—Pull-out sheet containing photographs of various models which were trial exhibits:

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

MOHASCO INDUSTRIES, INC., *Petitioner,* *vs.* E. T. BARWICK MILLS, INC., and BARWICK CARPET MILLS, INC., *Respondents.*	No. 253

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

This is a suit for the alleged infringement of two patents relating to the manufacture of tufted carpet.

The patents were held by both courts below to be invalid and not infringed.

The decisions of invalidity were soundly based on the factual conclusion of both courts that the subject matter was obvious to persons skilled in the art and hence unpatentable under 35 U. S. C. § 103.*

No unusual point of law is involved, and there has been no other decision with respect to the patents; there is no valid reason for granting the writ.

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*"§ 103. Conditions for patentability; non-obvious subject matter

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

1. The Decisions below Are Not Impugned by the Fact that the District Court Agreed with Respondents' View of the Case and Based Its Opinion and Findings Largely on Respondents' Brief and Proposed Findings

In the first of its three reasons for granting the writ, petitioner seeks to invoke this Court's supervisory powers on the ground that the District Court "shirked its judicial duties" because it adopted from respondents' pre-trial brief, and included in its opinion, much of a discussion of the law concerning the requirement of "invention" (including a discussion of the pertinent decisions of this Court), which petitioner characterizes as "permeated with a philosophy antagonistic to the patent system and to patentees." Petitioner also complains because the District Court adopted, with only minor changes, proposed findings of fact submitted by respondents.

Petitioner overreaches in citing *Chicopee Mfg. Corp.* v. *Kendall Co.*, 288 F. 2d 719, 724 (4 Cir. 1961), cert. denied 368 U. S. 825 (1961) in support of its criticism of the District Court's use of respondents' trial brief and proposed findings, for what occurred and was properly condemned in *Chicopee* was wholly different from what occurred in this case. In the present case briefs and proposed findings were submitted by both parties as an *inter partes* matter; in *Chicopee*, the opinion adopted by the Court was prepared and submitted to the Court by counsel for one of the parties without the knowledge of the other party. In the same paragraph of the Court's opinion as that in which the adoption of such an opinion was condemned as a denial of due process, the Court acknowledged the propriety of the procedure followed in the present case, saying (p. 724):

> "There is authority for the submission to the court of proposed findings of fact and conclusions of law by the attorneys for the opposing parties in a case,

and the adoption of such of the proposed findings and conclusions as the judge may find to be proper. See United States v. Crescent Amusement Co., 323 U. S. 173, 184, 65 S. Ct. 254, 89 L. Ed. 160; Saco-Lowell Shops v. Reynolds, 4 Cir., 141 F. 2d 587, 589; Schilling v. Schweitzer-Cummings Co., 79 U. S. App. D. C. 20, 142 F. 2d 82, 83; Simons v. Davidson Black Co., 9 Cir., 106 F. 2d 518; O'Leary v. Liggett Drug Co., 6 Cir., 150 F. 2d 656, 667."

The recent decision in *Roberts* v. *Ross,* 344 F. 2d 747 (3 Cir. April 29, 1965), which petitioner brings to this Court's attention in a motion for leave to supplement its petition, serves to emphasize the lack of merit in petitioner's contention for in it the Court expressly approves the procedure followed by the District Court in the present case, saying (p. 752):

> "We did not then [in one of its own earlier decisions], and do not now, mean to suggest that a trial judge should not have the right to invite counsel for both parties to submit to him proposed findings of fact and conclusions of law, accompanied by briefs if he desires them, to assist him in formulating his own findings and conclusions and reaching his decision. In the process of studying the facts and the law, findings and conclusions formulated and proposed by the parties may be most helpful to the judge in sharpening the issues and may serve a very useful purpose in aiding him in drafting his own findings and conclusions.[3] In most cases it will appear that

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"[3]See the excellent discussion of the subject by the Court of Appeals for the Second Circuit in The Jemson No. 1, 1941, 123 F. 2d 999, 1001. See also the illuminating discussion by Judge Gunnar H. Nordbye, Improvements in Statement of Findings of Fact and Conclusions of Law, 1940, 1 F. R. D. 25, 30, and Judge J. Skelly Wright, The Nonjury Trial—Preparing Findings of Fact and Conclusions of Law, Seminars for Newly Appointed United States District Judges, West Pub. Co., 1963, pp. 159, 166."

many of the findings proposed by one or the other of the parties are fully supported by the evidence, are directed to material matters and may be adopted verbatim and it may even be that in some cases the findings and conclusions proposed by a party will be so carefully and objectively prepared that they may all properly be adopted by the trial judge without change.[4]"

"[4]Most of the reported cases which have approved findings and conclusions which the trial judge has adopted in the form prepared by counsel without change involve findings and conclusions submitted before decision. And in many of the cases which involve findings and conclusions submitted after decision the trial judge filed an opinion or memorandum decision which outlined his findings and conclusions and thus afforded counsel information from which to formulate detailed findings and conclusions for him."

2. The Decisions of Invalidity Were Plainly Right

Petitioner's second reason for granting the writ attempts to take advantage of the circumstance that this Court has already granted certiorari in five patent cases, each involving the application of 35 U. S. C. Sec. 103, asserting that the present case would afford the Court an opportunity to discuss the meaning of that section from some standpoint different from what will be afforded by the other cases. We disagree and submit that the only practical result of granting a writ in the present case would be to put the Court under the necessity of examining a mass of evidence bearing on the extent to which the subject matter of these patents was obvious or unobvious to persons skilled in this art.

The lack of necessity for that exercise and its inappropriateness from the standpoint of the use of the time of this Court will be evident from the following brief description of the subject matter of the patents and the

very minor departure which they represent from the prior art:

The patents are concerned with pattern attachments by means of which patterns of high and low loops can be formed in the surface of tufted carpets.

The process of tufting (pushing loops of yarn through a backing) has long been used for making decorated bedspreads, but has been applied only recently to the manufacture of carpets. Tufted carpet as first made around 1950 was a somewhat sleezy product but since then various improvements (unrelated to the patents here in suit) have been made with the result that present-day tufted carpet is fully competitive with woven carpet.

A tufting machine consists, in substance, of a row of needles mounted in a bar extending across the width of the machines and arranged to be reciprocated vertically so as to insert loops of yarn in a backing sheet as it is advanced through the machine. Each needle acts in precisely the same manner as every other needle so the operation can be understood by consideration of the operation of a single needle; the rest of the machine is mere proliferation, adding apparent, but not real, complexity.

Each needle has an eye near its point and, as the descending needle penetrates the backing sheet, it pulls with it a loop of the pile yarn which is threaded through the eye. When a loop has been inserted in this way, it is temporarily held in position, as the needle withdraws on its upward stroke, by a small hook called a "looper" mounted underneath the backing sheet. Successive loops are formed in the same way by successive reciprocations of the needle as the backing sheet is advanced step by step through the machine. The relationship between the needle and looper in forming successive loops is shown in a sheet of drawings from a Thompson patent, which is included at the back of this brief as an appendix.

The ultimate length of each loop in the finished product is not determined by the depth of penetration of the needles, as one might at first think. In normal operation a loop, when first inserted, is of a length determined by the penetration of the needle and the location of the looper. But when the next loop is formed, the amount of yarn supplied by the feed to the needle will be somewhat less than the length of yarn required to form a full length loop. Accordingly, the descending needle will make up the deficiency in the feed by withdrawing the necessary amount of yarn from the immediately preceding loop, shortening it somewhat from its original length. This process, called "backdrawing," serves the beneficial purpose of tightening the back stitch as well as producing tufts of uniform length.

As will be evident from the foregoing, a tufting machine adjusted to produce loops of a given height can be made to produce higher loops by increasing the rate of yarn feed so as to reduce the amount of backdrawing. Conversely, to make the machine produce shorter loops the yarn feed is reduced so as to require more yarn to be withdrawn from the previously formed loops and thereby shorten them.

The dependence of pile height on the rate of yarn feed was well understood in this art prior to any activity of either of the patentees, and knowledge of this relationship was used not only to adjust the pile height of plain surface carpet but also to produce patterns of high and low loops. Indeed, an "interference" occurred in the Patent Office between the applications of nine different claimants to inventorship of the process of producing patterns of high and low loops by appropriately restricting the feed of yarn to the several needles. The interference was ultimately settled, and a patent on the basic process was awarded to one of the applicants, Boyles (V 1915). (Patents were also awarded to each of the other applicants on one or another feature of the machines by which they proposed to practice

this process.) The Boyles patent, covering the use of the basic backdrawing process to produce patterns of high and low loops, was one of several patents relating to the same general subject which were acquired by a patent holding company called Tufted Patterns, created for the purpose, and under whose patents respondents were and still are licensed (V 2136-2137).

Several methods exist for controlling the rate of feed of yarn. One is to run it in an S-shape over a pair of rolls and to vary the speed of rotation of the rolls. Another is to provide a pair of rolls running at different speeds and move the yarn into contact with one or the other of those rolls. Still another is to pass the yarn between a pair of intermeshing elements, such as gears, whose degree of intermesh can be varied. This last method of using intermeshing elements, whose degree of intermesh is variable, is the basis for feeding devices known as furnishing wheels in the knitting art and is also the basis for the patents here in suit.

The manner in which the rate of yarn feed is controlled in a feeding device depending on the use of intermeshing elements is simple and straightforward. The yarn as it passes between the intermeshing elements necessarily follows a zig-zag path. This is shown in relation to a pair of intermeshing gears, representing an elementary furnishing wheel, in the left-hand figure on the pull-out at the back of this brief. When the intermeshing gears are rotated enough to release a length of yarn previously imprisoned between a pair of intermeshing teeth, the length of yarn released will correspond to the degree of intermesh. To illustrate, if the right-hand gear in the figure, which is movable toward and away from the mating gear, is moved away (to the right) the degree of intermesh is reduced and so is the length of each increment of yarn as successive zig-zag waves of yarn are released from engagement with

the pair of intermeshing teeth between which it was previously restrained.

In the Odenweller patent in suit, the principle of operation is the same; the amount of yarn fed by each increment of rotation of two members with intermeshing elements is varied by varying the degree of intermesh. In Odenweller, which is represented by the model shown in the second picture from the left in the series of five on the pull-out at the back of this brief, one of the rotating elements (the one on the right) is a cog or pinion having intermeshing teeth or elements of uniform height. The teeth on the other rotating element (on the left) are of varying heights. When the yarn is released from engagement with a tall tooth, a correspondingly long length of yarn will be released. When a short tooth comes into the zone of engagement, a correspondingly short length will be released. By suitably varying the height of the teeth, the rate of yarn feed can be varied in such a way as to produce successive loops of heights which vary in accordance with whatever pattern the designer wishes.

To facilitate the explanation, the foregoing description has been concerned with only a single yarn, fed between a single pair of intermeshing elements. But, as previously noted, the operation of every needle in a tufting machine is the same as that of every other needle. The same is true of the feeding mechanism. In a machine having 1000 needles for producing carpet 15 feet wide, the rotating members comprising the feeding mechanism would be correspondingly long. Each individual end of yarn would have its own established path between the intermeshing elements *en route* to its own individual needle and the rate of feed of each individual end of yarn would be established and controlled in exactly the same way as the single end shown in the pull-out figure, by varying the depth of the notch cut in each of the variable height elements to establish its path of travel.

The device of the Odenweller patent, involving intermeshing teeth mounted on the surfaces of a pair of drums, was never put into commercial use. But early in his consideration of the matter Odenweller realized that either or both of the intermeshing elements could be mounted on chains instead of on a drum (V 2102), as shown in the third picture on the pull-out. Crawford, of Mohasco, in his subsequently devised version of such a feeding device, mounted the intermeshing elements or teeth on chains instead of drums, as shown in the fourth picture on the pull-out.

To complete the series of pictures on the pull-out, the fifth picture shows such a device producing a succession of loops of varying height, corresponding to varying degrees of intermesh of the intermeshing elements.

We believe it clear from the foregoing explanation of the relationship between furnishing wheels and the pattern attachments of the patents here in suit that the Courts below were right in their determination that the devices of the patents in suit involve nothing inventive over furnishing wheels of the prior art, or to put the same thing in another way (and in the language of the statute) that the devices of the patents in suit would have been obvious to anyone skilled in this art at the time, and especially so to anyone acquainted with furnishing wheels and the principle underlying their operation.

This conclusion based on consideration of the natures of the devices and their relationship to one another is confirmed by the fact that substantially the same sort of feeding device or pattern attachment was devised at about the same time by several different "inventors" acting independently of one another. This is a factor which many decisions say may be taken into account in determining whether the subject matter should be classified as obvious or not. See, e.g., *Safety Car Heating & Lighting Co.* v. *General Elec. Co.*,

155 F. 2d 937, 939-40 (2 Cir. 1946), *Graham* v. *Jeoffroy Mfg.*, 206 F. 2d 769, 771 (5 Cir. 1953), *Thomson Co.* v. *Ford Motor Co.*, 265 U. S. 445, 452-53 (1924), *McElrath* v. *Industrial Rayon Corporation*, 123 F. 2d 627, 629 (4 Cir. 1941), all cited in the District Court's opinion. See also, to the same effect, *Concrete Appliances Co.* v. *Gomery*, 269 U. S. 177, 185 (1925).

Petitioner says that the independent developments should not have been taken as evidence of obviousness because each of the independent developers made at least one false start, its theory apparently being that anything not achieved until after a false start could not be "obvious." The Constitutional purpose of promoting the progress of science and the useful arts would scarcely be promoted by a rule of law which established as unobvious, and therefore subject to appropriation by patenting, any development which was preceded by a single attempt along some other line. See, in this connection, *Toledo Co.* v. *Standard Parts*, 307 U. S. 350, 356 (1939).

3. The Holding of Non-infringement Is Proper and in Accordance with Long-established Law

The basis of the holding of non-infringement is, that in the operation of respondents' pattern attachments no attempt is made to synchronize them with the tufting machines they feed, whereas in the devices of the patents in suit the pattern attachments are synchronized with the tufting machines in such a way as to release a wave of yarn of the desired length for each specific needle stroke. Petitioner complains that this feature is described in the patent specifications and in at least one claim but not in all of them, and that in determining infringement it is the claims that must be looked at to define the patent's scope. While this is true as a generality, it is well settled that infringement or non-infringement is a matter of principle and not

mere words. This Court's succinct statement on the point in *Westinghouse* v. *Boyden Power Brake Co.*, 170 U. S. 537, 568 (1898), is directly applicable, and the non-infringement holding is in full accordance with it:

> "But even if it be conceded that the Boyden device corresponds with the letter of the Westinghouse claims, that does not settle conclusively the question of infringement. We have repeatedly held that a charge of infringement is sometimes made out, though the letter of the claims be avoided. *Machine Co.* v. *Murphy*, 97 U. S. 120; *Ives* v. *Hamilton*, 92 U. S. 426, 431; *Morey* v. *Lockwood*, 8 Wall. 230; *Elizabeth* v. *Pavement Company*, 97 U. S. 126, 137; *Sessions* v. *Romadka*, 145 U. S. 29; *Hoyt* v. *Horne*, 145 U. S. 302. The converse is equally true. The patentee may bring the defendant within the letter of his claims, but if the latter has so far changed the principle of the device that the claims of the patent, literally construed, have ceased to represent his actual invention, he is as little subject to be adjudged an infringer as one who has violated the letter of a statute has to be convicted, when he has done nothing in conflict with its spirit and intent."

CONCLUSION

Directly applicable here is the rule stated in *Keller* v. *Adams-Campbell Co.*, 264 U. S. 314, 319 (1924):

> "Such an ordinary patent case with the usual issues of invention, breadth of claims and non-infringement, this Court will not bring here by certiorari unless it be necessary to reconcile decisions of Circuit Courts of Appeal on the same patent."

Also, *Graver Mfg. Co.* v. *Linde Co.*, 336 U. S. 271, 275 (1949):

> "A court of law, such as this Court is, rather than a court for correction of errors in fact finding, cannot undertake to review concurrent findings of fact by two courts below in the absence of a very obvious and exceptional showing of error."

The petition should be denied.

Respectfully submitted,

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July 15, 1965

APPENDIX A

Feb. 12, 1957 R. L. THOMPSON 2,781,007

APPARATUS FOR MAKING PILE FABRICS

Filed March 17, 1953 3 Sheets-Sheet 3

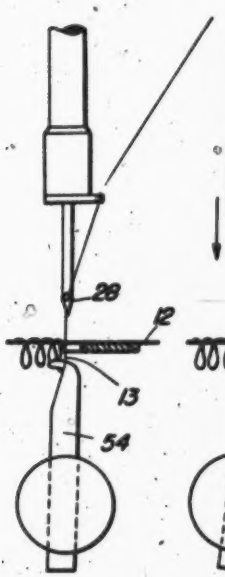


FIG. 5

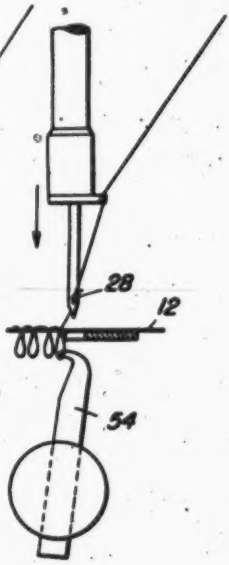


FIG. 6

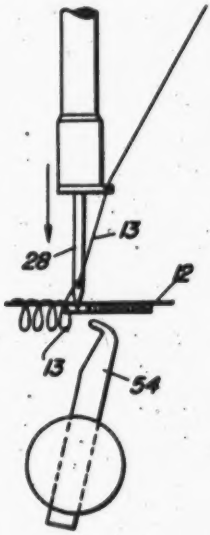


FIG. 7

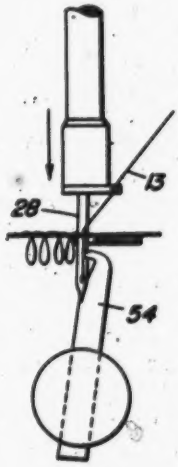


FIG. 8

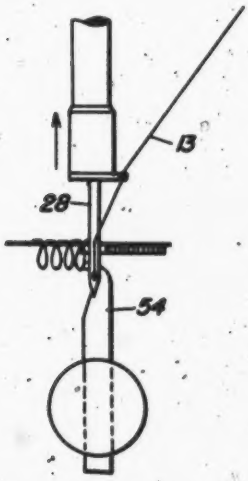


FIG. 9

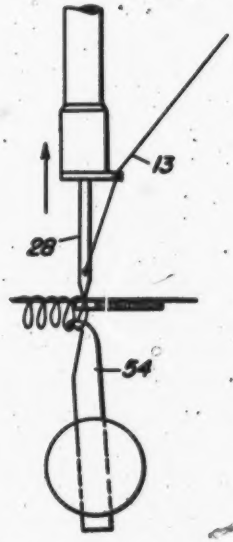
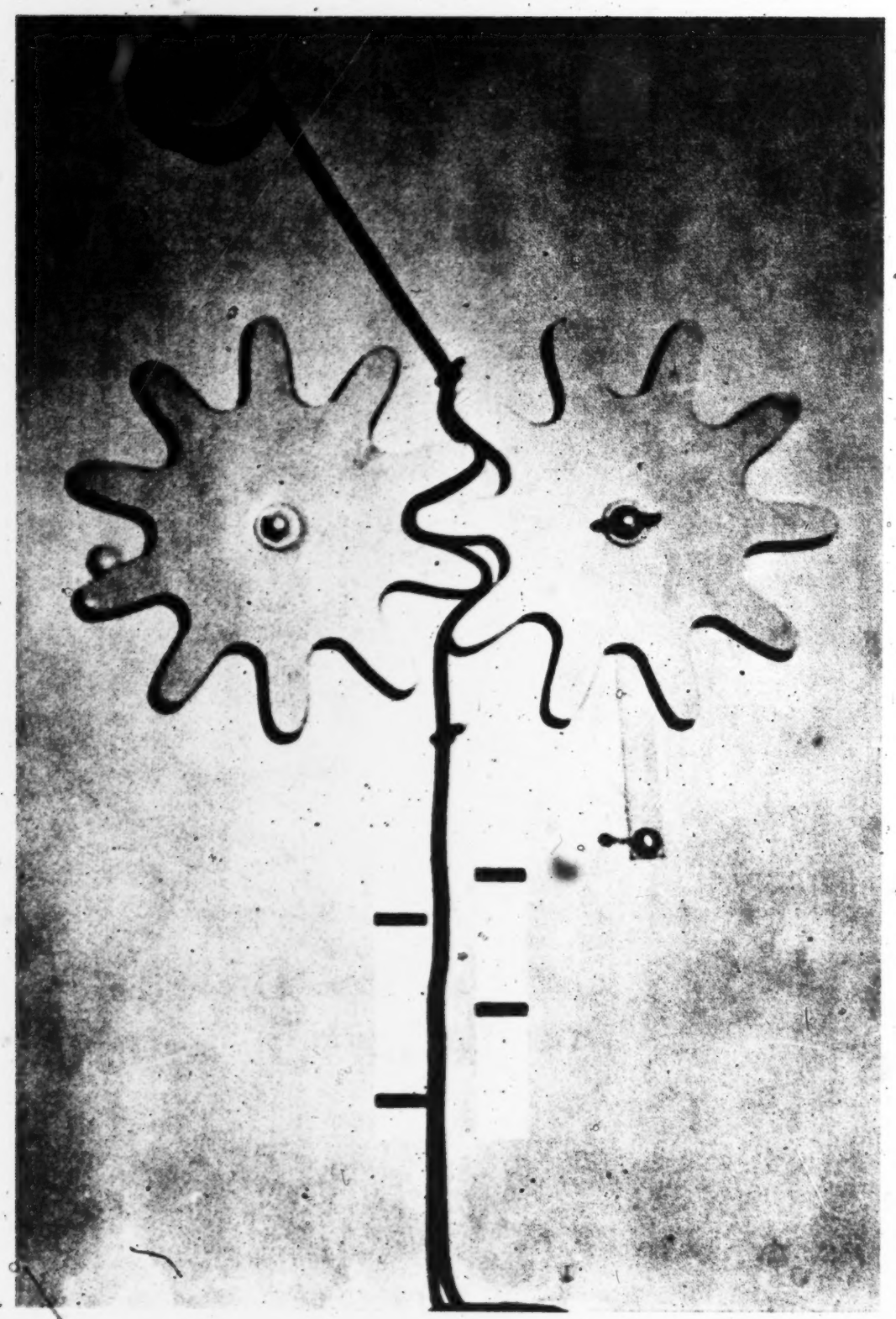


FIG. 10

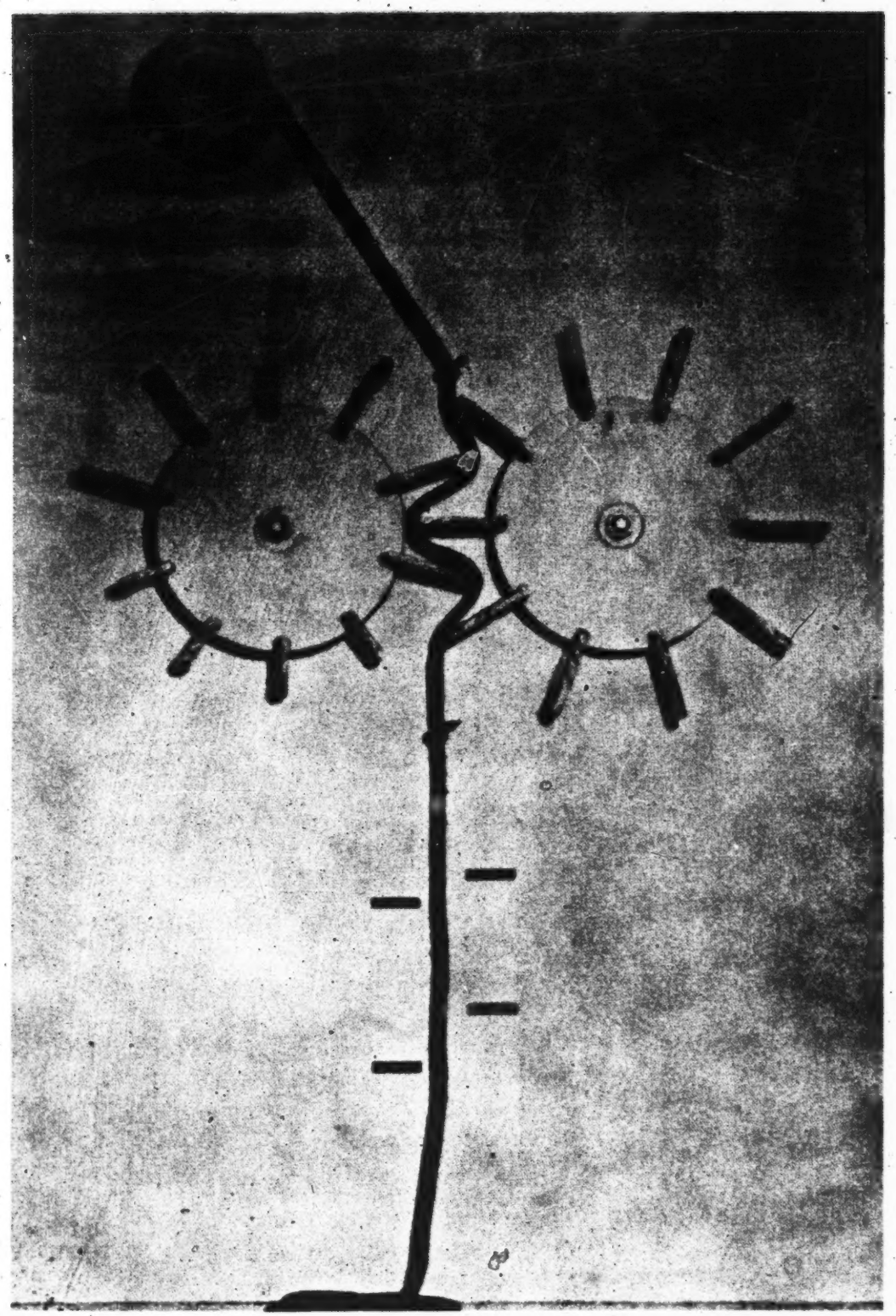
INVENTOR.
Roscoe Lee Thompson
BY
Parmelee, Munson, Morton, Barrow & Taylor

(V 1884)



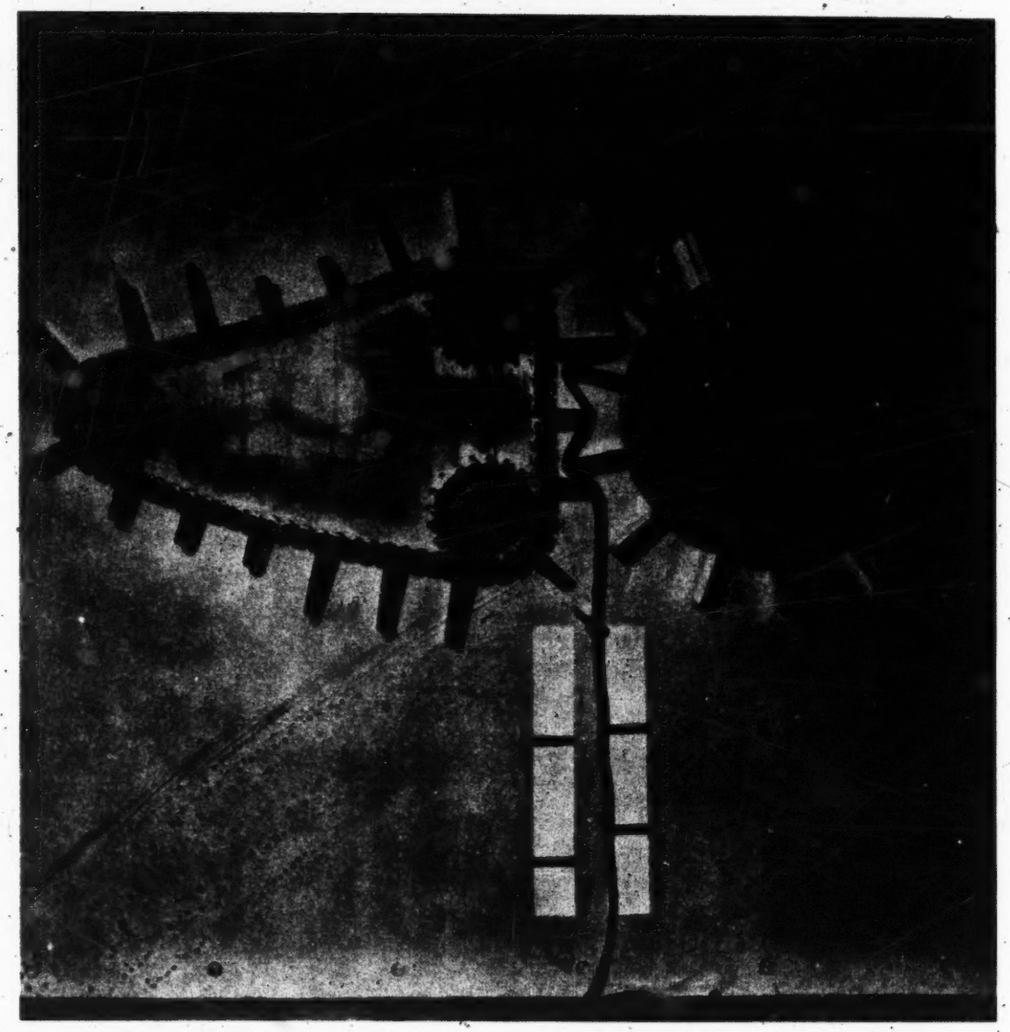
INTERMESHING GEARS
(furnishing wheels)
(DX-5A)

(V 1984)



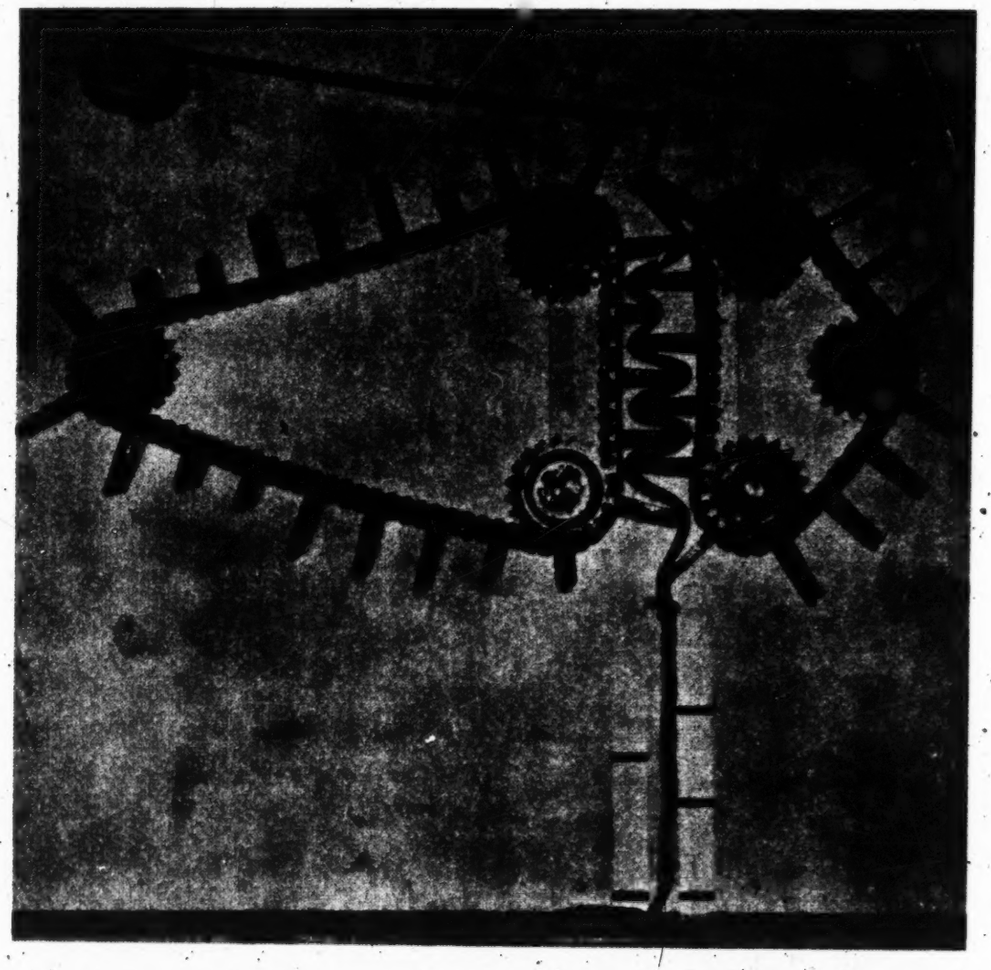
VARIABLE FEED BY INTERMESHING SLATS ON DRUMS
(variable height slats on left-hand drum;
fixed height slats on right-hand drum)
(DX-6A)

(V 1985)



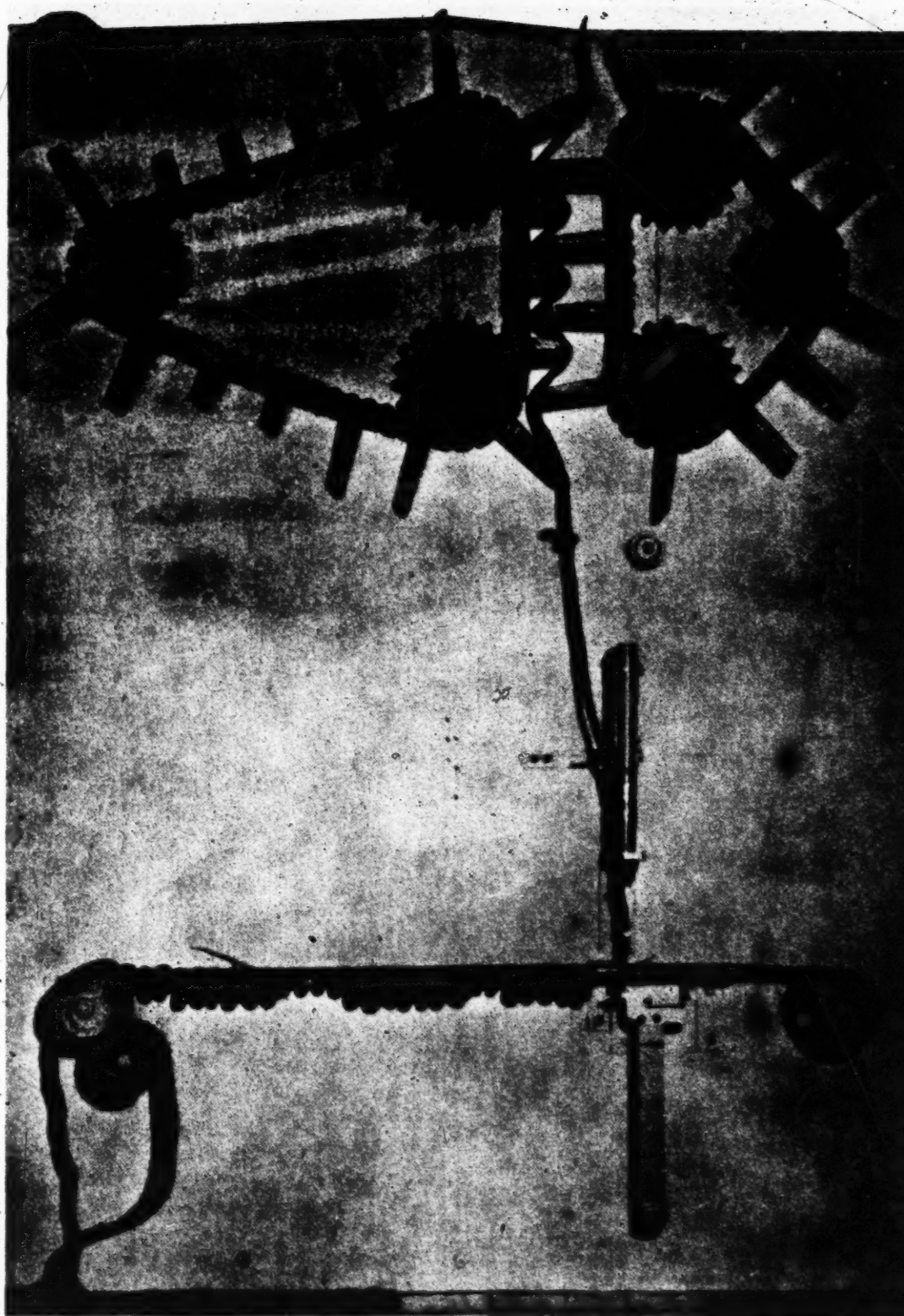
VARIABLE FEED BY INTERMESHING SLATS ON CHAINS OR DRUMS
(variable height slats on chain;
fixed height slats on drum)
(DX-7A)

(V 1986)



VARIABLE FEED BY INTERMESHING SLATS ON CHAINS
(variable height slats on left-hand chain;
fixed height slats on right-hand chain)
(DX-8A)

(V 1987)



MODEL TUFTING MACHINE WITH
SLAT PATTERN ATTACHMENT
(DX-9A)

(V 1988)

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AUG 17 1965
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No. 253

MOHASCO INDUSTRIES, INC.,

Petitioner,

vs.

E. T. BARWICK MILLS, INC.,

and

BARWICK CARPET MILLS, INC.,

Respondents.

PETITIONER'S REPLY BRIEF

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PETITIONER'S REPLY BRIEF

Respondents' Comment on the First Reason for Granting the Petition is Misleading and Without Merit

Respondents' comment on the first reason for granting the petition (P 11-15)[1], namely, the failure of the District Court to perform its judicial duties with resultant denial of due process to petitioner, describes the actions of the

[1] References to pages in the petition and in the brief in opposition are indicated by "P" and "RB", respectively, followed by the page number.

District Court inaccurately and ignores pertinent parts of the *Chicopee*[2] and *Roberts*[3] decisions.

Respondents state as a fact that the District Court "based its opinion and findings largely on respondents' brief and findings" and "adopted from respondents' pre-trial brief and included in its opinion, much of a discussion of the law concerning the requirement of 'invention'" (RB 2). These statements are half-truths implying that the opinion, except for excerpts from respondents' pre-trial memorandum (I 130-160), was original with and reflected the thought and judgment of the District Court and that the Court prepared findings, some of which had been proposed by respondents.

The fact is that the District Court was not the author of any significant part of the opinion; instead, the opinion is an almost verbatim copy of the first section of a memorandum filed by respondents months before the trial and thus expresses only the thoughts of respondents' counsel. The opinion contains no discussion of the prior art or of the differences between the prior art and the patented devices and says that subject matter of the patents was obvious for the sole reason that three people built slat attachments as soon as the occasion to do so arose (I 61), a reason for which there is no support in either the decisions or the record (P Appendix C).

The District Court prepared no findings but, instead, adopted with inconsequential changes all the twenty-five findings submitted by respondents at the request of the Court. Here again, the Court failed to perform its judicial function and deprived petitioner of the benefit it would have received had the Court written its own findings and studied the record while so doing. A careful examination

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[2] *Chicopee Mfg. Co.* v. *Kendall Co.*, 288 F. 2d 719, 724.

[3] *Roberts* v. *Ross*, 344 F. 2d 747, 752.

of the record would have prevented the making of the principal findings, on which the conclusions of invalidity and non-infringement are based. Those findings are Nos. 10, 12, 15, and 25, and we showed in the petition (P 8-11) that such findings are all in direct conflict with the record. Respondents have made no answer to our assertions.

Respondents have cited no cases approving the adoption by the District Court as its opinion of a brief written by counsel for the winning party but say (RB 2) that the condemnation of *Chicopee* applied only to the lack of notice to the losing party that the opinion was prepared by the winning party and that both *Chicopee* and *Roberts* upheld the adoption of findings proposed by a party. In support of that statement, respondents quote from *Chicopee* but stop quoting too soon. The court said:

> "... there is no authority in the federal courts that countenances the preparation of the opinion by the attorney for either side. That practice involves the failure of the trial judge to perform his judicial function and when it occurs without notice to the opposing side, as in this case, it amounts to denial of due process."[4]

In the present case, the adoption by the District Court as its opinion of the first section of respondents' pre-trial memorandum without significant change was the equivalent of having the opinion prepared by respondents' counsel, since the opinion was not the product of the performance by the trial judge of "his judicial function". Petitioner received a copy of respondents' memorandum at the time it was filed but was never given any notice that the District Court had utilized a part of the memorandum as its opinion. The conduct of the District Court thus falls within both parts of the condemnation of *Chicopee*.

---

[4] *Chicopee* v. *Kendall*, 288 F. 2d 719, 724.

The statement in *Chicopee* that there is authority for the adoption by a judge of findings proposed by counsel is not an expression of unqualified approval of such long, argumentative, slanted findings as were adopted by the District Court in this case and *Roberts* does not "expressly approve[s] the procedure followed by the District Court" (RB 2, 3). *Roberts* said that a trial judge has the right to request counsel to submit findings of fact and conclusions of law "to assist him in formulating his own findings and conclusions and reaching his decision", since, in "the process of studying the facts and the law, findings . . . proposed by the parties may" aid the judge "in drafting his own findings and conclusions". *Roberts* approved the adoption of findings proposed by a party which are "fully supported by the evidence" and "are directed to material matters" and said that "it may even be that in some cases the findings and conclusions proposed by a party are so carefully and objectively prepared that they may all properly be adopted".

An examination of the findings prepared by respondents in this case will show that they are not all "directed to material matters" or "objectively prepared" and we have shown without contradiction by respondents that the principal findings are in direct conflict with the record. Neither *Chicopee* nor *Roberts* approve such findings and respondents have found no other decisions to cite.

The assumption that underlies all the cases which discuss the preparation by the parties of findings of fact at the request of a court and the adoption of some of those findings is that, in arriving at its decision, the court will make a painstaking review of the record and will prepare its own findings of the facts, on which the decision is based. If some of the findings prepared by counsel are accurate and stated concisely and without bias, adoption of such findings by the Court is not objectionable, although such a case is exceptional and the practice is not to be

encouraged. In the present case, the District Court evidently did not examine the record before filing its opinion and findings, for, had it done so, it could not in good conscience have adopted as its own the erroneous statements in respondents' memorandum and findings. The District Court thus "departed from the accepted and usual course of judicial proceedings" and the Court of Appeals "so far sanctioned such [a] departure . . ., as to call for an exercise of this court's power of supervision".

Respondents' Comment on the Second Reason for Granting the Petition is Irrelevant

The second reason advanced by petitioner for granting the petition is that the courts below did not employ the criteria of Sec. 103 in holding the patents invalid in that the courts gave the word "obvious" of that section a meaning known only to themselves and not to be found in any dictionary and ignored the phrase "subject matter as a whole". Respondents do not deny these statements but argue the merits by attempting to show that the patents in suit are invalid for obviousness of the patented inventions in view of prior art, which was considered by the Patent Office in granting the patents, bolstered up by pictures of models which mis-represent the patented attachments.

The prior device relied on by respondents to establish invalidity of the patents in suit is the furnishing wheel feeder used with circular knitting machines for feeding a single yarn to the knitting needles. Such feeders are discussed in the petition (P. 7-9) and it is there pointed out that a furnishing wheel feeder is employed to produce an even and uniform feed of yarn and no use of such a feeder under control of a pattern mechanism to feed its yarn at an irregular rate determined by the pattern is known. Respondents' explanation of the construction and mode of operation of a furnishing wheel feeder (RB 7, 8) adds

nothing to that in the petition, while the models shown in the pictures in respondents' brief convey a false impression by over-simplification and omissions.

Model DX-5A consisting of a pair of meshing gears with one gear movable by a handle toward and away from the other represents with reasonable accuracy a furnishing wheel feeder of the manually adjustable type. The model is provided with no means for automatic control of the movable gear and such a device can feed one yarn only. Accordingly, if an attempt were made to use a furnishing wheel feeder to supply the pile yarns to the thousand needles of a tufting machine at varying rates as determined by a pattern, a thousand such feeders would be required and it would be necessary to devise a pattern control mechanism capable of controlling the feeders individually. Moreover, a furnishing wheel feeder feeds its yarn with incidental slippage so that it is not obvious that a furnishing wheel feeder could supply its yarn accurately in varying lengths when operated at tufting machine speed of 600 cycles a minute with possible changes in the adjustment of the movable wheel relative to the fixed wheel occurring at the same rate.

Model DX-6A does not accurately represent the slat attachment of the Odenweller patent in suit in that it includes only one feature of the Odenweller attachment which distinguishes it from a furnishing wheel feeder, and fails to show others. The feature of the model which is original with Odenweller and was never disclosed or suggested before his work is the set of teeth on one drum varying in height in accordance with a pattern. The model is deficient in that it feeds a single yarn only, whereas the Odenweller attachment may feed a thousand yarns or more at the same time and at individually varying rates. The high and low teeth on the drum at the left in the model cannot convey the idea of slats running the full width of the tufting machine and notched for each of the many yarns passing between the two drums. The model does not include the

necessary guides for the individual yarns which are provided in the Odenweller attachment before and behind the drums and the model does not make clear that a slat attachment feeds yarns without slippage.

Model DX-6A is a typical product of hindsight prepared in an attempt to show that the devices of the patents in suit would have been obvious to a person of ordinary skill. However, under Sec. 103, a patent is invalid only if "the subject matter as a whole" would have been obvious to a person of ordinary skill. A determination of validity of the Odenweller patent cannot properly be made merely by comparing a model (DX-5A) representing a furnishing wheel feeder with a model (DX-6A) which shows only one feature of the Odenweller attachment, since a consideration of the attachment "as a whole" necessarily involves an examination of all the differences between the attachment and the feeder in purpose, construction, mode of operation, and results produced. Neither court below considered the respective patented attachments "as a whole" and thus neither Court properly applied one of the criteria of patentability set up in Sec. 103.

Respondents would have it appear (RB 9) that the Crawford attachment differs from that of Odenweller only in that the slats are mounted on chains instead of drums, and model DX-8A was constructed to show only that feature. The model is misleading for the reasons given in connection with model DX-6A and, in addition, model DX-8A omits an important feature of the Crawford attachment which was wholly original with Crawford, namely, the fixed parallel guides (IV, 1420; Fig. 3, parts 42, 50) which engage the lengths of the chains carrying the meshing slats and hold the chains parallel and the meshing slats in constant mesh. If the guides are not used, the parallel stretches of the chains bulge apart and this results in inaccurate yarn feeding. Such a bulge is visible in the vertical stretch in the chain at the right in the photograph of model DX-8A.

Respondents' assertion that the decisions of invalidity were right is equivalent to saying that a person of ordinary skill acquainted with furnishing wheel feeders would have had no difficulty in devising an attachment for feeding a large number of yarns to the needles of a tufting machine at individually varying rates in accordance with a pattern and would have at once made a slat attachment for the purpose. The fallacy in this assertion is that it assumes that the only difference between a wheel feeder and a slat attachment is that, with a feeder, a change in the rate of yarn feed is accomplished by varying the spacing between the wheel centers whereas, in a slat attachment, the rate of yarn feed is changed by varying the height of the slats. What the assertion ignores is that, in the use of a furnishing wheel feeder, the sole purpose is to feed a single yarn at a uniform rate, despite changes in yarn tension, in order to produce uniform stitches, and no one has ever operated a furnishing wheel feeder under the control of a pattern or devised a pattern mechanism for so doing. A slat attachment operates in the opposite manner to produce the opposite result; it feeds a large number of yarns independently of one another at non-uniform rates determined by the pattern and the result is pile loops of non-uniform height. The development of a slat attachment by a person familiar with furnishing wheel feeders would require him to forget the characteristic features and purpose of and the results produced by such a feeder and to create a wholly new element, namely, sets of meshing slats with the slats of one set notched to different depths as determined by the pattern. Such an achievement would necessitate a flight of the imagination far beyond the powers of an ordinary artisan and the Patent Office so held in granting the patents in suit in the face of prior patents on furnishing wheels.

Respondents say (RB 9) that the pattern attachments of the patents are shown to be obvious by the fact that the attachments were invented by a number of different people

at about the same time. There is no rule of law that mere multiple invention, simultaneous or not, establishes obviousness and, in every case cited by respondents (RB 10), the patent was clearly invalid for other reasons and the fact of multiple invention merely confirmed a decision based on other grounds. If multiple invention alone proved obviousness, there would be no need for such statutory provisions as 35 U. S. C. § 135 for determining priority of invention among multiple inventors; every patent act since that of 1793 has contained a corresponding provision.

Whether or not the slat attachment was obvious, that is, "capable of easy perception; requiring very little insight to perceive, recognize, or comprehend'"[5] is best shown by the history of the efforts of the several persons who attempted to solve the problem of providing independent control of the individual pile yarns being fed to a tufting machine. That history appears in Appendix C accompanying the petition and it shows that four inventors took periods varying from six months to about six years to devise the slat attachment now asserted to be obvious, and, in his initial effort, each one produced something, which was wholly different from a slat attachment and did not give the desired result. The failure of the joint inventors, Parker[6] and Short, to devise a slat attachment in their first attempt is especially strong evidence that the attachment was not obvious; at the time, they were familiar with a tufting machine having feed rolls with meshing gear teeth (III 1032-3) and they could have converted the rolls into a slat attachment merely by notching the teeth of one roll. But that simple change never occurred to them and they did did not conceive the slat attachment until about 18 months later and long after Odenweller and Crawford.

---

[5] Webster's Third New International Dictionary, page 1559.

[6] Parker is a skilled inventor with more than 25 patents to his credit (III 1015-9).

Williams[7] knew about gears for feeding yarns (III 1200-1) at the time he first realized the desirability of feeding individual yarns to a tufting machine under independent control but he resorted to many unsuccessful expedients over a period of about six years before the slat attachment dawned upon him. That was long after its invention by Odenweller and Crawford (III 1157).

If the slat attachment was the obvious solution of the problem facing the four inventors, why did they not adopt it at once? If it was obvious, it was easy to perceive and such highly skilled persons as Parker and Short and Williams would never have passed it by for something else that proved to be a failure. Odenweller and Crawford had the same experience of initial failure. When the courts below held the slat attachment obvious despite the history of its development, they gave the word "obvious" a new and uncertain meaning and made Sec. 103 obscure and almost meaningless. The situation calls for an interpretation of that section by the Court and the petition should therefore be granted.

Respondents' Comment on the Third Reason for Granting the Petition Misses the Point

In the petition, we showed that the decisions below imposed on the claims in suit restrictions not required by the patents or by the proceedings in the Patent Office, denied petitioner the benefit of the doctrine of equivalents, and violated the canon of claim interpretation that a limitation expressed in one claim may not be implied in another. Respondents' only comment is the citation of a decision[8]

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[7] Williams is a highly ingenious person and has obtained two patents and made about 50 developments put into use in the tufting field (III 1117-20).

[8] *Westinghouse* v. *Boyden*, 170 U. S. 537, 568.

holding that "infringement is sometimes made out, though the letter of the claims be avoided" and vice versa. There can be no quarrel with the pertinence of the decision but it does not justify a holding of non-infringement in this case, where the accused attachment contains the same characteristic features as the patented attachment and performs the same function in the same way to produce the same result. Moreover, the cited decision does not nullify the doctrine of equivalents or the canon of claim interpretation relied on by petitioner.

Conclusion

This Court has made clear that, as a court of law, it will not grant certiorari in an ordinary patent case except to resolve a conflict between two Courts of Appeal and that it will not review concurrent findings of fact by two courts below in the absence of obvious and exceptional showing of error. The present case is not an ordinary patent case but presents as issues the proper interpretation of terms in Sec. 103 not heretofore considered by this Court and the proper application of the doctrine of equivalents and of a fundamental rule of patent claim construction. Petitioner has made an exceptional showing of error and has pointed out without contradiction by respondents that the principal findings of fact upon which the decisions below were based are in direct conflict with the evidence. Finally, the case involves an example of the failure of the trial court to perform its fact finding function and of the improper supervision of that function by the appellate court which calls the exercise by this Court of its supervisory authority.

The vice in the actions of the courts below lies not only in the injustice done petitioner but also in the evasion of the responsibilities of those courts to the public, the courts of other circuits, and possibly to this Court. The patents

are of great commercial importance and may well be the basis of litigation in other circuits. In any subsequent suit, the trial and appellate courts would ordinarily find the decisions in this case of assistance and entitled to substantial weight even though not controlling. If the patents are sustained in a later suit and ultimately come before this Court, the decisions here ought to be of help in resolving the conflict. However, in this case, the opinion and findings of the District Court prepared by counsel for the respondents and a four sentence *Per Curiam* decision by the Court of Appeals, which does not state the rationale of the decision or make clear the rules of law applied, will be of no help to any other court and are not entitled to the weight which the law normally accords them.

For the above reasons, the petition should be granted.

Respectfully submitted,

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